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IN THE

# United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

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OCTOBER TERM, 1913.

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SHERMAN, CLAY & COMPANY,

a Corporation,

*Plaintiff-in-Error.*

*vs.*

SEARCHLIGHT HORN COMPANY,

a Corporation,

*Defendant-in-Error.*

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## ***Brief on Behalf of Plaintiff-in-Error***

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**STATEMENT.**

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This is a writ of error in an action at law to reverse the judgment of the U. S. District Court for the Northern District of California, in a suit for alleged infringement of a patent for horns for talking machines. The defendant below, plaintiff-in-error, Sherman, Clay & Company, are dealers in musical

instruments, and are charged with selling, with certain talking machines purchased by them from the Victor Talking Machine Company, of Camden, New Jersey, a particular construction of horn alleged to infringe U. S. Patent No. 771,441, issued October 4, 1904, to P. C. Nielsen, for horns for phonographs alleged to belong to the plaintiff below, the Searchlight Horn Company. The alleged infringing horns were bought with the machines by Sherman, Clay & Company from the Victor Talking Machine Company. Why the plaintiff below in this case, which is a corporation of the State of New York, did not bring its suit for alleged infringement against the Victor Talking Machine Company, a corporation of the State of New Jersey, which it had previously threatened with infringement, and which company supplied the horns with its machines to its dealers, or did not sue the Standard Metal Manufacturing Company, of Newark, New Jersey, which manufactured the said horns, but saw fit to cross the continent and bring suit in California against one of the many dealers of the Victor Talking Machine Company, is not shown. The plaintiff below had previously, as long ago as May 1906, as shown by the evidence, threatened the Victor Talking Machine Company with suit for the alleged infringement, but never sued the said Victor Company, or did anything further until comparatively recently, when this suit was brought against this dealer on the Pacific Coast in May 1911, the Victor Company being led to believe, as it had a right to, that the plaintiff had abandoned its unjust claim. For convenience, the

Searchlight Horn Company will be herein referred to as the plaintiff, and Sherman, Clay & Company as the defendant.

The alleged infringing horns of a style known as the "flower horn" were sold quite largely for a while by numerous talking machine companies with their talking machines, such as the Edison Phonograph Company, the Victor Company and the Columbia Company, among others.

The defendant in this case sets forth invalidity of the Neilsen patent in suit, denies infringement, and further contends that the proofs clearly show that the alleged infringing horns in this case were made by and bought from a licensed manufacturer, irrespective of the question of whether the horns infringe, or the patent is valid, and that no infringement is proven.

It was shown by plaintiff's evidence in this case that on May 8, 1908, the plaintiff, the Searchlight Horn Company, which had been previously manufacturing some horns embodying what was alleged to be the patented construction, but was not successful, was obliged to go out of business, and turned its business and machinery over to the Standard Metal Manufacturing Company, of Newark, N. J., under an arrangement of that date, authorizing it to continue the manufacture of the said horns. (Record 80, bot. page 81, etc.) It is also shown by the testimony of Mr. W. H. Locke, Jr., the President of the plaintiff Company, (Record 83) that the Standard Metal Manufacturing Company is the largest manufacturer of talking machine horns in the country, and that "it manufac-

tures the bulk of the horns for the Edison Phonograph Company and the Victor Talking Machine Company.” Mr. Locke testifies that the Standard Company divided the profits on the horns—50 cents on the 19 inch horn like Plaintiff’s Exhibit 15, and \$1.30 profit on the 23 inch horn like Plaintiff’s Exhibit No. 14, which are the alleged infringing horns. He also testifies on being asked who were the manufacturers of the horns for the Victor Talking Machine Company, “A. I understand that most of the horns are manufactured by the Standard Metal Manufacturing Company, but The Tea Tray Company **may** make some of their horns. On being asked (Record 86) again regarding the matter as to whether the Standard Metal Manufacturing Company manufacture the horns for the Victor Talking Machine Company, Mr. Locke states, “They did, and I have no doubt that they do today.”

Mr. Locke also testifies in another place (Record 83) to the question, “**Was the Standard Manufacturing Company supplying the entire market?** A. **Yes, sir.**”

It is shown also by Mr. Locke (Record 85-86) that the plaintiff, the Searchlight Horn Company, previous to the date that it ceased manufacturing the said horns on May 8, 1908, supplied the defendant, Sherman, Clay & Company; he also shows that since then the Victor Talking Machine Company supplies Sherman, Clay & Company.

Therefore, according to the plaintiff’s own evidence the defendant bought the said horns before the Searchlight Horn Company went out of busi-

ness on May 8, 1908, from it, and that subsequently, it bought the alleged infringing horns from the Victor Talking Machine Company, which, in turn, purchased them from the Standard Metal Manufacturing Company, plaintiff's licensee, to whom the plaintiff had turned over its business. Plaintiff's counsel may contend that the arrangement with the Standard Metal Company related only to the manufacture of the so-called folding horn, but it is clear from a careful reading of Mr. Locke's deposition that the arrangement with the Standard Metal Manufacturing Company related to **all the horns** the Searchlight Company had been manufacturing previous to May 1908, including the 19 inch horns and the 23 inch horns to which Mr. Locke refers (Record 82-83, etc.) Plaintiff's Exhibit 14 representing the 19 inch horn, and Exhibit 15 representing the 23 inch horn, which are the alleged infringing horns in evidence. (Produced at pp. 46 and 83 of the Record).

The plaintiff's evidence shows that the Searchlight Horn Company, prior to May 8, 1908, had made the horns. "Defendant's Exhibit T," previously marked for identification W, referred to as the "folding flower horn," which the plaintiff marked with both the Villy reissued patent, issued January 30, 1906, and the Nielsen patent in suit, issued October 4, 1904 (Record 84), and it is also shown that they made some horns which were not folding, such as "Plaintiff's Exhibits 9, 10, 11, 12, 13," in evidence in the case.

"Plaintiff's Exhibits 14 and 15" represent the alleged infringing horns, though there is **no evidence**

dence that these identical horns were ever sold by the defendant, Sherman, Clay & Company. "Exhibit 14" is offered on page 46 of the Record, and "Exhibit 15" is offered on page 83 of the Record. Plaintiff apparently relies on the testimony of the witness, McCarthy, (Record 93, etc.) to show that these exhibits represent the kind of horns that Sherman, Clay & Company sold during a period of six years prior to the date of suit brought.

The most that can be made out of this proof is, if anything, that the defendant **during a period of six years** prior to April or May, 1911, sold 7456 horns like Exhibits 14 and 15, but whether defendant sold them all since May, 1908, or any before May, 1908, **does not appear**. They may have all been sold since May 8th, 1908.

**There is no evidence that any of these horns were sold by the defendant prior to May 8, 1908.**

There is, therefore, no evidence of infringement in this case under these proofs, and the Court below manifestly erred in not instructing the jury on this ground to find for the defendant, among other things.

Apart from the failure of proof on the part of the plaintiff as to alleged infringement, the defendant has, we think, shown clearly that in view of the prior art hereinafter particularly considered, there was no patentable invention in claim 2 or 3 of the Nielsen patent in suit (claim 1 not being in issue). The so-called "flower horn" had been previously invented by one G. H. Villy, and patented to him September 29, 1903, U. S. patent No. 739,954, and by Reissue patent No. 12,442 of January 30, 1906.

If Nielsen was entitled to any claim, which we deny, it was to but a very narrow specific construction, embodying among other things a horn having a particular form of **outwardly directed flanges** constituting longitudinally arranged ribs, particularly specified in claims 1 and 2. Claim 3, must also be held invalid. The defendant's alleged infringing horn does not embody these specific features of claim 2. If the claim 2 is to be broadly construed, it is manifest, as before stated, that it also contains nothing patentable in view of the prior art.

In this connection the Court erred, among other things, in its instructions to the jury to the effect that **in doubtful cases** if it was shown that the patented device had gone into general use, and superseded prior devices, **that this was sufficient to justify the jury in finding the patent valid.** This we submit, was obvious error, as hereinafter pointed, and of itself sufficient to warrant a reversal, and new trial. (Record p. 274-5.)

As hereinafter particularly pointed out, the Court below also erred, among other things, in its interpretation of the scope of the patent, as given in its instructions to the jury; it also erred in its interpretation of the law relative to patents in its instructions to the jury, and in refusing to admit certain important evidence, as well as in refusing to instruct the jury on certain points, as requested by the defendant; all of which is hereinafter particularly considered in detail.

After the judgment in this case the plaintiff also filed a bill in equity against this defendant for alleged infringement based upon the judgment in the

action at law, and a preliminary injunction was issued. An appeal from this decree is now also before this Honorable Court in this equity suit (Appeal Case No. 2307) argued at the same time with this writ of error.

A preliminary injunction was also entered in a suit in equity in the Court below by this plaintiff against the Pacific Phonograph Company for alleged infringement of the Nielsen patent based upon the judgment of the Court below in this action at law, in which equity suit an appeal has been taken and is now before this Honorable Court for review.

#### **A Word Concerning the Villy Reissue Patent.**

The plaintiff, the Searchlight Horn Company, is the alleged owner of the two patents referred to, viz., the Villy reissue patent, No. 12,442, issued January 30, 1906 (being a reissue of patent No. 739,954, of September 29, 1903) and the Nielsen patent, No. 771,441, of October 4, 1904, the patent in suit. The United States Horn Company, the plaintiffs' predecessor in business, had both of the said patents in its name prior to November 15, 1906, about when the plaintiff claims to have acquired title to them. Shortly prior to the assignment to the plaintiff, the United States Horn Company had the Villy patent, No. 739,954, of September 29, 1903, reissued to incorporate **seven additional and broader claims**, of which claim 8 of the Villy reissue, No. 12,442, is an example.

It was doubtless manifest to the plaintiffs' predecessor that of the two patents, the Villy and Nielsen, the Villy patent, No. 739,954, of Septem-

ber 29, 1903, was the earlier and broader invention, and should contain broader claims. The claims of the original Villy patent, among other things, were limited to the **collapsible** horns.

The United States Horn Company, therefore, re-issued the Villy patent, incorporating into it 7 broader claims. One of the main features of the reissue claim was the characteristic construction going to make up the **bell-shaped** and **flaring effect** through the medium of the curved flexed tapered strips. The new claims, such as claim 8, called for the horn comprising,

- (a) A number of flexed strips having curved meeting edges;
- (b) Means for joining the edges;
- (c) The strips being so flexed and the edges so curved and joined that the horn is given a trumpet-like or bell-like form;
- (d) The strips forming angles where the edges meet.

The reissue only differed from the original Villy patent in the addition of these 7 broader claims.

The plaintiff then claims to have acquired title to both the Villy reissue, with these new broader claims, and to the Nielsen patent, and by notice to the trade, dated November 15, 1906, notified the manufacturers and dealers that "all of the so-called 'Flower Horns' made by our aforesaid competitors are flagrant infringements of said patents"—the Villy reissue and Nielsen. (See Locke affidavit and circular attached in Appeal Case No. 2307, equity, between these parties and before this Court, pp. 45-52.)

This circular first quotes claim 8 of the Villy re-issue patent, and then also adds claim 3 of the Nielsen patent, without designating them by numbers.

When, however, the plaintiff now brings suit against a dealer, four years later, it does not sue on the Villy patent, for doubtless well considered reasons, but brings suit for alleged infringement of the claims of the Nielsen patent, and in Court urges that the Nielsen patent claims all the features which are specified in the Villy re-issue, claim 8, etc. The Court, being misled, and knowing nothing about the Villy reissue, and refusing to allow it in evidence, instructs the jury (Record pp. 272-3, etc.) that the Nielsen invention embodies in its claim these features, which are, in fact, the features characteristic of the Villy patent, and claimed by it, as set forth in the circular of November 15, 1906; as a matter of fact, these features are not noted or specified in the Nielsen claims, and are no part of them.

The Court in substance attributed to Nielsen the main feature of the invention of Villy, and regarded Nielsen as the inventor, and in interpreting the scope of the claims of the Nielsen patent, instructed the jury to this effect.

With this brief preliminary statement we will consider the case in detail.

### **STATEMENT IN DETAIL.**

This is a writ of error to reverse the judgment of the United States District Court for the Northern District of California. The action is one at

law, brought by the Searchlight Horn Company, a corporation of the State of New York, plaintiff, against Sherman, Clay & Company, a corporation of the State of California, defendant, to recover damages for alleged infringement of U. S. patent No. 771,441, issued October 4, 1904, to P. C. Nielsen for Horns for Phonographs, or Similar Machines, to which the plaintiff now claims title. The action was brought May 9, 1911 (Record 6), and came on for trial October 1, 1912. The jury, after having been charged by the Court, rendered a verdict in favor of the plaintiff, and assessed the damages against the defendant in the sum of \$3578.00 (Record 14-15 and 28). The defendant, at the conclusion of the testimony, and before the charge of the Court (Record 267) moved the Court to direct a verdict for the defendant on the ground that claims 2 and 3 of the patent in suit were void of patentable invention, and that neither of the claims had been infringed. This motion, among others, the Court denied, and exception was duly noted. The jury returned the verdict as noted in accordance with the charge and instructions of the Court, finding the patent valid and infringed. (See charge of the Court, Record 268-279). Exceptions were duly taken to the charge (Record 279,282). The original judgment (Record 15-16) was subsequently amended, taxing the amount of the judgment at \$1.00, plaintiff remitting the amount of the original judgment (Record 18), and the amended judgment in the sum of \$1.00 was duly entered June 2, 1913 (Record 19-20). A motion for rehearing had been duly made on behalf of the defendant, but was de-

nied shortly prior to the entering of the amended judgment. The writ of error was subsequently sued out by the defendant May 23, 1913 (Record 345, etc.), and the bill of exceptions duly settled July 14, 1913 (Record 306, etc.). See petition for writ of error (Record 307) and assignment of errors (Record 308, etc.).

The answer of the defendant denied, generally and specifically, each and every of the allegations contained in plaintiff's declaration (Record 8), and notice of special matter was duly set up (Record 9-14). The defenses, in substance, are:

- (a) No patentable invention in the claims sued on.
- (b) The invention, as claimed, is anticipated by the prior art.
- (c) Non-infringement of the specific construction claimed in claim 2 sued upon.
- (d) License, shown by plaintiff's proofs.

These are mainly the questions to be reviewed by this Court, in addition to the points regarding the admission and rejection of certain evidence covered by the assignment of errors, as well as the errors of the Court in its instructions to the jury, and its failure to give other instructions, as also set forth in the said assignment of errors, and hereinafter more particularly considered.

The specification of errors relied upon appears at pages 308-339 of the Record. All of the assignments it will be unnecessary to consider. Those mainly relied upon are as follows (Record 308-340):

## ASSIGNMENT OF ERRORS RELIED UPON.

## III.

The said Court erred in refusing to admit in evidence on behalf of the defendant United States re-issue Letters Patent No. 12,442, granted G. H. Villy, January 30, 1906, for improvement in horns for phonographs, ear trumpets, etc., the same being a re-issue of United States Letters Patent No. 739,954 granted G. H. Villy, under date of September 29, 1903, and being Defendant's Exhibit "O."

## IV.

The said Court erred in refusing to permit the defendant's witness, William H. Smyth, to answer at the trial the following question:

"With the patent in suit before you, will you please compare the device therein disclosed with the devices which you find in 'Defendant's Exhibit Tea Tray Horn No. 20,' and state such differences and similarities as you find existing between the two."

## V.

The said Court erred in refusing to grant the defendant's motion made at the close of the testimony in the case, which said motion reads as follows:

"The defendant moves the Court that the jury be directed to find a verdict for the defendant upon the ground that claims two and three of the patent in suit are void for want of patentable invention, and, second, that neither of said claims have been infringed by the defendant."

## VI.

The said Court erred in instructing the jury as follows:

“The horn is constructed of metal strips secured together at their longitudinal edges by a seam, which produces ribs on the outside of the horn. In the patent this seam is shown as being a flanged or butt seam, and these flanges extend outwardly thereby forming longitudinal ribs on the outside of the horn; the sheet metal strips are curved and flexed outwardly, but this curve is more abrupt adjacent to the outlet of the horn or the mouth or large end, thereby producing a bell-shaped horn with a flaring outlet. This is the mechanical structure described in the specification, and after specifying the method of construction the patentee has added the following clause.”

## VII.

The said Court erred in instructing the jury as follows:

“Now, the invention actually covered by the patent does not reside in the particular form of the seam which joins the metal strips together. If the same result produced by the flanged seam shown in the patent as joining the metal strips together is obtainable by any other usual form of seam known at the time of Nielsen’s invention, which operates in substantially the same way to produce the same result, then the substitution of such a seam would not be a departure from the invention, but would be within its real and true scope. The invention of Nielsen consists in the production of a horn for phonographs and similar instruments consisting of a combination of the various elements hereinabove described by me,

and the essential characteristics of the Nielsen horn are the following:

“1. It must be composed of a multiplicity of metal strips secured together at their longitudinal edges by a seam.

“2. This seam must be of such construction as to produce longitudinal ribs on the outer surface of the horn.

“3. The strips are narrower in cross section at the inner end than at the outer end.

“4. The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent to the outer end.

“Now, combining these elements together in this way, Nielsen produced a horn for phonographs and similar machines larger at one end than the other and having substantially a bell shape and abruptly flaring outlet made up of longitudinally arranged metal strips secured together at their outer edges by a seam of such character as to produce longitudinal ribs on the outer surface.”

### VIII.

The said Court erred in instructing the jury as follows:

“No more exact definition can readily be given you of what constitutes invention as distinguished from mere mechanical skill; but there is one established principle or rule which can be easily understood and followed in determining that question whenever the facts of the case make it applicable. That rule is that in a doubtful case if it appears by the evidence that the patented device has gone into general use and has superseded prior devices having the same purpose, that fact is sufficient evidence of invention and is valid.”

## IX.

The said Court erred in instructing the jury as follows:

“If, therefore, you find that at the date of Nielsen’s invention the lock seam was a mechanical equivalent to the flanged or butt seam in the sheet metal art, and that they both accomplished the same result in substantially the same manner as a seam and rib when used in phonograph horns, then you must find that the two things are mechanical equivalents and that the defendant is not relieved from the charge of infringement merely because its horns use the lock seam instead of the flanged or butt seam.”

## X.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“In view of the action of the patent office as disclosed in the file wrapper and contents and the prior art as established by undisputed testimony, the plaintiff’s patent necessarily belongs to a class which is very narrow, and the patentee is limited to the precise device or devices and combinations shown and claimed in his patent.

“The plaintiff’s patent is in no sense a primary or a pioneer patent. It evidently belongs to an old art which appears to have advanced step by step for many years as the demand of the trade required. If, therefore, you find from the evidence that the defendant has not made, used or sold a horn for phonographs of the precise description, construction and mode of operation disclosed in one or more of

the claims mentioned in the patent, then you must find for the defendant."

## XI.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"It is a well-established rule of law that the patentee cannot make an infringement of the thing from which he differentiated his invention in order to obtain his patent. 191 F. R., 588.

"It appears from the file wrapper of this case that the patentee sought to patent a claim reading as follows: 'A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs substantially as shown and described.' This claim was rejected. You will notice that it called for a horn of the usual form, the body on the outside thereof being provided with longitudinally arranged ribs. In other words, it simply means a phonographic horn tapering in the usual manner with ribs longitudinally arranged on the outside thereof. This claim having been rejected, of course, the patentee cannot now claim that a horn constructed in the usual manner, simply with longitudinal ribs arranged upon it, can be held to be an infringement of the patent."

## XII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The patentee also endeavored to have a claim allowed to him in his patent reading as

follows: 'A horn for phonographs and similar instruments, said horn being larger at one end than the other and being composed of longitudinal tapered strips which are secured together at their edges, which are substantially as shown and described.' This claim was also rejected; consequently, the patentee of the patent in this action cannot claim that a phonographic horn simply composed of longitudinal strips, secured together at their edges, is an infringement of his patent."

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The patentee also endeavored to have a claim allowed to him in his patent reading as follows: 'A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs between which the longitudinal parts of the horn tapered from one end to the other, substantially as shown and described.' This claim was rejected. This claim, no doubt, was intended to cover, and had it been allowed it would have covered, any phonographic horn tapered from one end to the other and having longitudinally arranged ribs between which the parts of the horn taper.

"You will notice that this claim did not mention a plurality of strips, or any strips. It would have only required that a horn should be made in any manner, that is, either in one piece or a plurality of pieces or strips, and then arrange the ribs on the body of the horn on the outside in any suitable manner, the horn tapering from end to end. Of course, if it tapered from end to end and the ribs were arranged on the body of the horn, the tapering would necessarily be between the ribs. At any rate, what-

ever might be the meaning of this claim, it was rejected, and the Court instructs you that this claim having been rejected the plaintiff cannot claim as an infringement a horn tapering in the usual manner from end to end and the outside of the body thereof being provided with longitudinally arranged ribs.

“Applying these remarks to the case in hand, the Court instructs you that exhibits \_\_\_\_\_ could not be held as an infringement of the plaintiff’s patent because they appear to have been constructed substantially as described in the last mentioned rejected claim, even though you call the seamed union with its necessary protuberance, a rib.

“The patentee, upon a rejection of these claims, abandoned them and accepted his patent without them, and consequently he is bound by this action, and phonographic horns, when constructed according to these claims, are not infringements of his patent, and all that was so abandoned is now public property and free of the patent monopoly.”

### XIII.

“Applying these rules of law directly to the case in hand, you will take the defendant’s exhibits\_\_\_\_\_, which are shown by the testimony, and if you believe them or either of them to have been made or used long prior to the date of the plaintiff’s patent or the application thereof, as testified to, you will examine their construction and their mode of operation; you will ascertain how the joints are formed as shown by the models and the testimony, and what sort of protuberances there are on the outside and how they are formed, and if you find that they show a horn made up of a plurality of strips, no difference how many or how few, so there is more than one, and that the protuberances on the outside are ribs in

the sense of the patent in suit, and that the union of the strips are united by means of the ordinary and old lock, lap or flanged joints or seams, then you must find for the defendant.

“A device may combine utility and novelty in a high degree and still be only the result of mechanical skill as distinguished from invention. A person to be entitled to a patent may have invented or discovered some new and useful art, machine, manufacture or composition of matter, or some [269—248] new or useful improvement thereof, but it is not enough that a thing be new in the sense that, in the shape or form in which it is produced, it shall not have been known, and that it be useful; but it must amount to an invention as required by the patent laws of the country. A mere difference or change in the mechanical construction in the size or form of the thing used, in order to obviate known defects existing in the previous devices, although such change be highly advantageous, and far better and more efficacious and convenient, does not make the improved device patentable. In order to be patentable, it must embody some new idea or principle not before known.”

## XVII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“You will notice that assuming that there is any invention covered by any of these claims, the invention is a very narrow one as herein-before stated, and while, as a rule of law, all patents are to some extent entitled to the application of the doctrine of equivalents, however, in a patent so limited by the prior art as the one in suit must be, the application of the

doctrine of equivalents is likewise limited."

## XX.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"Now, the Court instructs you that it is not invention to produce a machine which any skilled expert mechanic, who knew that the old horns were objectionable on account of the mechanical vibratory and metallic sound produced by them, could produce whenever required.

"The process of development in manufacture creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper out-growth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequence. The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacture. Such an indiscriminate creation of exclusive privileges tends rather to

. . . obstruct than to stimulate invention. It creates a class of speculative schemers, who make it their business to watch the advancing wave of improvement and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.

“Would not a skilled expert in this art who knew that, on account of the weakness of the body of the horn, this vibratory and metallic sound was produced, also know that if he added a sufficient amount of metal to the body of the horn, that it would tend to strengthen and prevent it, and would he not also know that this result might be produced by any other means of strengthening the body of the horn, and would he not know that you might strengthen the body of the horn by the addition of a sufficient number of ribs, so-called, as well as in any other way. Ribs in the mechanic arts are something that is very ancient, and used for a great many purposes, and usually for the purpose of strengthening the body of something. It is defined by Webster as being ‘a bar, strip, rod or the like used to support, strengthen or shape something, as a rib of an umbrella cover,’ also ‘a ridge, fin or wing as on a plate, cylinder, beam, etc., to strengthen or stiffen it; a prominent line or ridge in woven or knitted goods; a longitudinal strip of metal uniting the barrels of a double-barrel gun; a curved side connecting the front and back of an instrument of the violin class.’” (See Atlantic Works vs. Brady, 107, U. S. 192.)

## XXII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

“Applying these rules of law directly to the case in hand you will take defendant's exhibits ——, which are shown by the testimony, and if you believe them or either of them to have been made or used long prior to the date of the plaintiff's patent or the application thereof, as testified to, you will examine their construction and their mode of operation; you will ascertain how the joints are formed, as shown by the models and the testimony, and what sort of protuberances there are on the outside and how they are formed, and if you find that they show a horn made up of a plurality of strips, no difference how many or how few, so there is more than one, and that the protuberances on the outside are ribs in the sense of the patent in suit, and that the union of the strips are united by means of the ordinary and old lock, lap or flanged joints or seams, then you must find for the defendant.

“A device may combine utility and novelty in a high degree and still be only the result of mechanical skill as distinguished from invention. A person to be entitled to a patent may have invented or discovered some new and useful art, machine, manufacture or composition of matter, or some new or useful improvement thereof, but it is not enough that a thing be new in the sense that, in the shape or form in which it is produced, it shall not have been known, and that it be useful; but it must amount to an invention as required by the patent laws of the country. A mere difference or change in the mechanical construction in the size or form of the thing used, in order to

obviate known defects existing in the previous devices, although such change be highly advantageous, and far better and more efficacious and convenient, does not make the improved device patentable. In order to be patentable, it must embody some new idea or principle not before known."

#### XXIV.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"A mere change in form of an old machine, or the mere rearrangement of the parts of an old machine without producing any new result, or any result or function substantially different from the result of function of the old device, does not constitute invention.

"If, therefore, you believe from the evidence in the case that the plaintiff's alleged invention, if any, was merely an adaptation of the idea and principle and function disclosed by these old horns and that the alleged patented invention consisted only of such changes in the construction of these old horns as would suggest themselves to a mechanic skilled in the art without inventive conception on his part, and that the change from the old devices to the plaintiff's device required and really involved only the skill and ingenuity of the mechanic which he had by reason of his knowledge and experience in his calling, and did not require or involve the exercise of the inventive faculties, as distinguished from such skill and ingenuity, then your verdict should be for the defendant.

"And the Court further instructs you that so far as this proposition is concerned, the whole question comes down to the simple one as to whether these old horns which have been put

in evidence, or any of them, disclose sufficient facts in their construction or mode of operation as to suggest to the patentee in this case, or any skilled mechanic, the arrangement and combination or parts shown in the patents; that is to say, with all of these old horns before him would it have required anything beyond the skill of a mechanic skilled in this art to have made such alterations and changes as may exist between the patented horn and the said old horns. If not, then the patent is void for want of invention, and you must find for the defendant."

## XXVII.

The said Court erred in refusing to give to the jury the following instruction requested by the defendant:

"The defendant has instructed in evidence a patent issued to one Villey, dated \_\_\_\_\_, \_\_\_\_\_, 1903, for the purpose of anticipating the plaintiff's patent. The plaintiff's expert witnesses, as well as the defendant's, testified point blank that the machine described in this patent was constructed in the same manner as the machine described in the plaintiff's patent, and in fact was the same thing. If you believe this to be true, the Court instructs you that the plaintiff's patent is void for want of novelty and invention, and you should find for the defendant.

"In determining the question as to the invention made by Nielsen, the patentee, you must consider all of the evidence and exhibits introduced which was shown to have been in use prior to the date of the plaintiff's patent and see if there is any substantial difference which involved invention, to produce between these old horns of the prior art and that

covered by the patent under the rules of law given to you by the Court, and if you should find that there is invention, the next question is what was the invention of the patentee, and whether the defendant has sold any horns such as comes within the terms of the patent as explained to you by the Court, and if defendant has not sold any such horns your verdict must be for the defendant."

Assignment XVIII which appears in the Record, (pp. 319-321), is also relied upon, to which the attention of the Court is directed.

### **Brief Consideration of the Assignment of Errors Relied Upon and Exceptions Relative Thereto.**

The assignment of errors relied upon are mainly III, IV, V, VI, VII, VIII, IX, X, XI, XII, XIII, XVII, XX, XXII, XXIV and XXVII, as hereinbefore set forth (see record, page 308 to 340).

These assignments embody substantially all of the errors relied upon in this case, and it is respectfully submitted that they are based, as will appear from the record, upon properly taken exceptions.

Plaintiff's counsel in his brief, as well as on the argument, has made certain comments upon the sufficiency of the exceptions, upon which these assignments are based, but we respectfully submit that these comments are without substantial foundation.

We will briefly refer to the assignments and exceptions upon which they are based.

## ASSIGNMENT III. (Record, page 309).

This is an important assignment relative to the refusal of the Court to admit in evidence the Villy Reissue Patent No. 12,442, being a Reissue of the original Villy Patent No. 739,954, dated September 29, 1903. Defendants Exhibit "O." The exception upon which this assignment is based is found on page 108 of Record. The importance of this Villy Reissue is fully considered at another portion of this brief, and we think that it appears beyond question that this Villy Reissue should have been admitted in evidence, for several reasons, among others, that the horn manufactured by the plaintiff, defendant's Exhibit "T," (see cut pg.— of this Brief), was marked by the plaintiff with this Villy Reissue patent, as well as with the Nielsen patent, and that the Villy Reissue Patent was the **connecting link** between the said horn made under the said patent and the original Villy patent forming part of the prior art. It was important, under the circumstances to know wherein the Reissue patent differed from the original as to the claims,—what it claimed,—especially in view of the fact that plaintiff put out some of its horns on the market claiming that they were patented under that reissue. Plaintiff also put out circulars to the trade dated November 15, 1906, (Equity Record, case No. 2307, page 51, 52), hereinafter fully considered, in which it notified the trade that numerous manufacturers were infringing upon the said Villy Reissue patent, and the said Nielsen patent, which patents were alleged to be embodied in the horn manufactured

by the plaintiff, Defendant's Exhibit "T," and marked with each of the said patents. It tended to show, among other things, that at that time the plaintiff notified the public that its said product was covered by the said Villy reissue patent, the original of which antedated the Nielsen patent, and the popular features, if any, were attributable to the Villy original patent, rather than to the Nielsen, as the Villy original patent disclosed and described the so-called flower horn considerably prior to Nielsen's date.

#### **The Villy Patent Reissued After Nielsen's Flanged Ribs Abandoned.**

It is also important to note that the testimony of the plaintiff's witnesses shows that while its predecessor, the U. S. Horn Company, first started to make the horn with the ribs formed by the Nielsen outwardly directed flanges, such as shown specifically in the Nielsen patent, about 1904-5, the plaintiff's predecessor in business, the U. S. Horn Company, shortly thereafter gave up the making of this particular construction of Nielsen rib, and went back to the lockseam, and made their horns thereafter with the lockseam. Further, that shortly after abandoning the Nielsen rib on the said horns, they on October 26, 1905, applied for a Reissue of the said Villy patent, No. 739,954, as appears on the face of the Villy Reissue Patent, in order manifestly, as subsequently appears by the Reissue to secure broader claims, which broader claims did not include the collapsible feature of the Villy horn, and which broadly claimed the bell-shaped or flower horn construction of the

Villy original patent, composed of a number of flexed longitudinal strips having **curved** meeting edges, with means for joining, the edges of the strips being so flexed and the edges so curved and joined that the horn is given a trumpet-like or bell-like form, the strips forming angles where said edges meet. These features are embodied in the reissued claims of the said Reissue patent.

The said patent was reissued to the said U. S. Horn Company, the predecessor in business and interest of said plaintiff, which company at the same time also owned the Nielsen patent. The U. S. Horn Company manifestly realized **when it abandoned the making of the Nielsen seam joined by the outwardly directed flanges on said horns, that it had no patent protection upon the said horns, and, therefore, secured the enlarged claims by reissuing the Villy patent to broadly cover the horn which it was then making, if possible.** It is, therefore, apparent that the Villy Reissue should have been admitted in evidence, and that there was error on the part of the Court in refusing the offer.

#### ASSIGNMENT IV. (Record, p. 309).

This assignment is based on the refusal of the Court to permit the defendant's expert witness, W. H. Smyth, to compare the device disclosed in the patent with the device found in "Defendant's Exhibit Tea Tray Horn," and to state such differences and similarities as he should find existing between the two. This assignment is based on exception appearing on page 105 and 106 of the record. Which exception duly covers the assignment.

We submit that it is clear that the question was a perfectly proper one, and that there was error on the part of the Court in refusing to allow the witness to answer the question, and to give his testimony relative thereto to the jury.

ASSIGNMENT V, (Record, page 310).

This assignment is based on exception appearing at page 267 of the record, which is manifestly a proper exception. The assignment relates to the defendant's motion that the jury be directed to find a verdict for the defendant on the ground that claims 2 and 3 of the patent in suit were void for want of patentable invention, and, second, that neither of the said claims had been infringed by the defendant.

Plaintiff's counsel has suggested a criticism of this assignment, which we submit is captious, and not well founded, to the effect that it does not affirmatively appear from the record that it contains all the evidence which was before the jury (Plaintiff's Brief, p. 22). We submit that there is no defect in the record, in this respect, and that the certificates, appearing at pp. 344 and 347 of the record, are full and complete, and answer all the requirements, and that nothing more was necessary. As to the merits, we submit that applying the test laid down in *Liberty Bell Gold Mining Co. vs. Smugglers Union Mining Co.*, 203 Fed. Rep., 800, and in *Coupe vs. Royer*, 155 U. S., 579, cited by plaintiff, there was no substantial evidence in the case at bar, which would warrant a jury in finding the issue against the defendant, and that,

therefore, the Court should have withdrawn the issue from the jury,—and instructed it to find for the defendant.

These subjects are hereinafter very fully herein-after considered, and we submit that it is clear that the Court was in error in denying the motion.

ASSIGNMENTS VI, VII AND VIII, (Record, pg. 310-312).

These assignments appear in the record, pages 310-312, and relate to the misconstruction of the scope of the patent by the Court, and the error of the Court in instructing the jury as to the invention, and the sufficiency thereof, based on the exceptions appearing on pages 279 and 282, of the record.

Plaintiff's attorney took exception (page 279) to that part of the Court's instruction upon subject of sufficiency of invention. There was a clear intent to except to each and every part of the charge in which the Court instructed the jury as to the **alleged invention and the sufficiency of the invention**, and we submit that this exception appearing on page 279, as well as on page 282, was sufficiently comprehensive, and was sufficient basis for the said assignment of errors. These exceptions were made immediately upon the conclusion of the charge to the jury; counsel was not able to take down the entire charge as delivered, but at once and promptly upon the conclusion of the charge, and before the jury retired, noted these exceptions to the Court, which in substance were stated to be exceptions to that part of the Court's instructions **upon the sub-**

ject of invention, or the sufficiency of invention. It is respectfully submitted that the exception is sufficiently comprehensive, and that the Court was thereby sufficiently apprised of the error now embodied in the said assignments to have corrected its charge to the jury before it retired, had the Court so desired.

#### ASSIGNMENT IX, (Record, pg. 312).

This assignment is based on exception on page 282 of the Record, which is not questioned. This relates to portions of the charge to the Court as to mechanical equivalents for the butt seam of the Nielsen patent, and the error of the Court in instructing the jury to this effect, that if it should find that at the date of Nielsen's invention the lock seam was a mechanical equivalent to the flanged or butt seam in the sheet metal art, and that they accomplished the same result in substantially the same manner, that the jury must then find that the two things are the mechanical equivalent, and that the defendant was not relieved from the charge of infringement merely because its horns used the lock seam, instead of the flange or butt seam. This assignment is based upon exception on page 282 of the record, concerning which there can be no question.

In the case of **limited specific claims** for specific improvements, the doctrine of equivalents does not pertain as in pioneer patents; where a patentee limits himself to a specific thing his claim must be interpreted as limited to that specific thing. (See record, page 276, 278).

## ASSIGNMENT X. (Record, pg. 313).

This assignment is based on exception, pages 279, 282, of the record, which we submit as clearly sufficient. The assignment relates to the refusal of the Court to instruct the jury relative to the narrow character of the invention as appears by the file wrapper, and the failure of the Court to instruct the jury that the plaintiff's patent was in no sense a primary or a pioneer patent.

Holt vs. Best, 172, Fed. Rep., 479.

ASSIGNMENTS XI, XII, XIII, XVII, XX,  
XXIV, AND XXVII.

These assignments were all based upon proper exceptions, record page 282, and were directed to the refusal of the Court to instruct the jury in accordance with the statements contained in the said assignments, which appear in the record between pages 322, and 340, as well as in this Brief, to which the attention of the Court is directed. These will not, for the purposes of brevity, be herein again set forth, or discussed at length separately. The subject matter of the said assignments is hereinafter fully considered in the body of the brief, in the discussion of the merits of the case, and the errors of the Court.

## ARGUMENT.

The argument will be mainly directed to a brief consideration of the prior art shown by the record in support of defendant's contention that claim 2

was restricted specifically to a particular construction, and limited in its terms to such construction, which is not embodied in defendant's device; that if otherwise construed claim 2 is manifestly invalid. That claim 3 is clearly invalid and embodied nothing patentable over the prior art, that the Court below misconstrued these claims of the patent, and misinstructed the jury as to the scope and extent of the invention and of the respective claims, and gave to the jury an erroneous construction of the claims and scope of the invention, thus misleading the jury, resulting in the finding of the verdict for the plaintiff. Other errors of the Court in its instructions to the jury will be also considered, relative to the question of mechanical equivalents, and the effect of the invention coming into general use upon the question of patentability. Also the error of the Court, in view of the failure of the plaintiff to prove infringement, to instruct the jury to find for the defendant.

Also the refusal of the Court below to be guided in its interpretation of claims 2 and 3 by the proceedings in the Patent Office, shown by the File Wrapper of the patent in suit, and its refusal to instruct the jury relative to the limitation of the claims in view of the File Wrapper, etc., as requested by defendant, will be urged as a manifest error. It is contended that claim 3 is palpably invalid, in view of the prior art, and that claim 2, if valid, embodies restrictions and limitations in a construction which **defendant's horn does infringe**.

It is also contended that while it is clearly shown by the record in this case in fact by plaintiff's

own witnesses, that the alleged infringing horns were made and sold by plaintiff's licensee, the Standard Manufacturing Company, under an agreement of 1908, entitling the Standard Manufacturing Company to manufacture and sell, and, as hereinbefore stated, there is no evidence in this case to show that any of these alleged infringing horns were sold by the defendant prior to the date of this license agreement; that, therefore, the Court erred in failing to instruct the jury that there was no proof of infringement, as well or on the ground that the defendant's construction did not embody the Nielsen flanged ribs.

Before, however, discussing these defenses, it is desired to consider briefly the Nielsen patent No. 771,441, and the subject-matter of the alleged invention.

#### THE NIELSEN PATENT NO. 771,441, OF NOVEMBER 4, 1904, IN SUIT.

We will here briefly consider the patent in suit, and the invention described. (See Book of Exhibits, pp. 3-5). The construction of the horn, the subject-matter of the patent, is illustrated in the drawings.

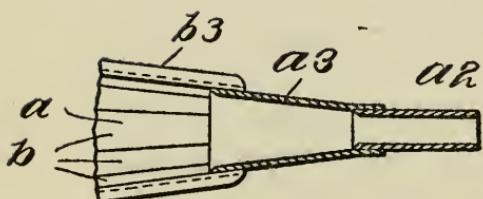
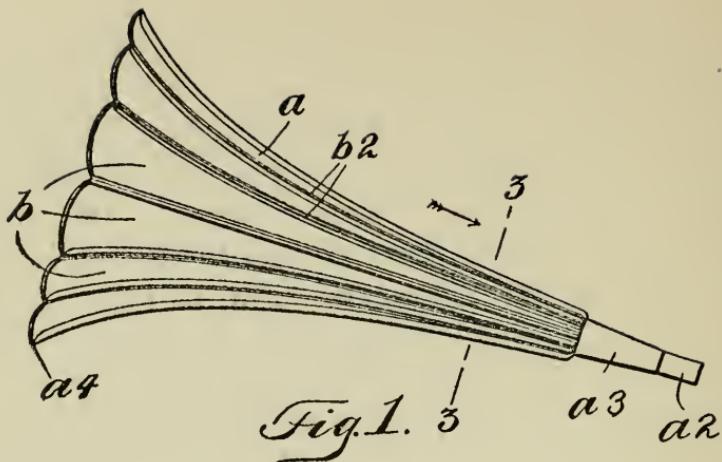


Fig. 4.

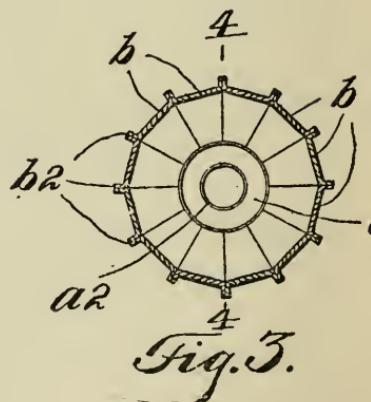


Fig. 3.

Fig. 1 is a perspective view; Fig. 3 is an enlarged elevation on the line 3-3 of Fig 1. Fig. 4 is a longitudinal section on the line 4-4 of Fig. 3.

The horn is for a phonograph, or talking machine, and the improvement described manifestly relies for its alleged novelty on its specific con-

struction, as is evidenced not only by a careful examination of the specification, but by an examination of the file-wrapper and contents (printed in the Record at pp. 170 to 183).

The specification states that one of the objects of the improvement is to do away with certain mechanical, vibratory and metallic sound of horns for phonographs, and states (p. 1, l. 71, etc.) that the longitudinal ribs  $b^2$ , as specifically described, "contribute mostly to the successful operation of the horn." It will be seen that, if Nielsen invented anything, he specified his **particular form of outwardly extending flanges  $b^3$  for forming a specific rib  $b^2$**  as the thing contributing "mostly to the successful operation of the horn." As we will herein-after point out, this specific form of longitudinal rib for uniting the sections of the horn formed of the outwardly extending flanges  $b^3$  were specifically embodied as elements in claims 1 and 2 of the patent, which were the original claims as originally filed. This is significant of the fact that this was what Nielsen thought he invented, and intended to claim, i. e., a horn for phonographs composed of longitudinally arranged strips of metal provided at their edges with longitudinally outwardly directed flanges for connecting the strips together, the said flanges  $b^3$  abutting together and forming the longitudinally arranged ribs  $b^2$  on the outside of the horn, the strips being tapered from one end of the horn to the other. Nielsen could hardly have intended to have claimed longitudinally ribs or seams of any construction, as these were old in the art, not only of the tin-smith, but of the horn-maker,

as a means of uniting the longitudinal edges of strips composing talking machine horns. Broadly speaking, ribs are mere joints, or seams, for securing the edges of metal strips together in talking machine horns, as well as in any other metal devices, and perform no function in metal horns not previously known, and accomplish only the usual functions of such metal ribs in talking machine horns.

Nielsen may have thought that his specific form of butt seam  $b^2$  formed of outwardly extending flanges  $b^3$  made a stiffer and more rigid rib, or joint, and thereby stiffened the horn to an extent that the ordinary lock seam did not, and he may have thought that, therefore, this particular construction of rib on this account contributed particularly to the successful operation of the horn, as stated by him on page 1, lines 71 to 77 of the specification, and he doubtless thought that this particular form of rib tended more than other forms of ribs to minimize the vibratory character of the horn and the metallic sound. Nielsen does not state in his specification, that he had discovered any new phenomenon, nor is it anywhere shown in the Record that he was the first to discover that ribs in talking machine horns minimize the vibratory character, or tended to do away with the metallic sound, but he manifestly thought that his particular construction of ribs specified were most efficient for this purpose. That ribs on the outside of talking machine horns tended to do away with the vibratory character and to minimize metallic sound, etc., was well known long prior to Nielsen's appli-

cation for patent, filed April 14, 1904, as shown by the Record in this case, as well as the Record in the suits by this complainant against Babson Bros. and the Pacific Phonograph Co., for alleged infringement of the same patent, argued before this Honorable Court on appeal at the same time with this suit. In this connection, we refer, among other things to the U. S. Patent No. 705,126, issued July 22, 1902, to Oster & Spaulding, of record in this case, Book of Exhibits pp. 45 to 47.

According to plaintiff's counsel's theory, the ribs minimized the vibratory character of the metallic sound by damming, or breaking up, the sound waves or pulsations produced in the walls of the horn, in the same manner as an obstruction in a pond of water would break the ripples formed by a pebble. It is, therefore, immaterial whether the ribs are longitudinal of the horn, or cross-wise. The horn of the Oster & Spaulding patent has the outwardly extending ribs, *h*, provided crosswise of the length of the horn, but the theory is the same. For the purpose of damming the sound, or minimizing the vibratory character of the horn, the ribs may equally well be provided longitudinally, or crosswise. The Osten & Spaulding patent states, (Record, p. 46, l. 74 to 88) "the ribs *h* act to strengthen the tone and vibrations, as well as making the horn more durable."

It also states

"The sound-posts and ribs are of special importance, as they act in practically the same manner as do the soundpost and ribs of a violin. They improve the tone quality by stiffening and mellow-

ing the same, at the same time increasing the carrying properties and distinctness of the sounds, particularly where the horn is made completely of wood."

The specification also states,

"The metallic sound so common to sound recording and reproducing apparatus is effectually eliminated."

It is unnecessary to cite further prior art in this connection, as this very fully sets forth the fact that this theory of using ribs on the outside of talking machine horns for this purpose was known long prior to Nielsen's alleged invention. In the suits above referred to against Babson Bros. and the Pacific Phonograph Co. other references are cited. In those cases testimony of several witnesses is produced to show that this alleged phenomenon was not only well known, but that it is also highly doubtful and problematical as to whether it does perform the function claimed for it. It might be noted in this connection, in passing, that the **plaintiff failed to produce any evidence** in this case whatsoever, of any practical witnesses skilled in the acoustical art to the effect that the alleged facts were true regarding the function of the ribs, nor was any witness produced who had made any direct test as to the merits, or efficiency of the horn, such as should have been produced in view of plaintiff's contention. If plaintiff's contention is true regarding this alleged function of the ribs, it was also true in the horns of the prior talking machine art constructed in sections united by metal seams, hereinafter referred to.

## The Bell-shaped Feature Formed No Part of the Nielsen Improvement.

The bell-shaped construction of horn *per se* forms no part of Nielsen's alleged invention, and the longitudinal strips going to make up the Nielsen horn are not described as having the characteristics of construction necessary to form this particular shape of horn. In other words, while Nielsen has illustrated in the drawing of his patent, Fig. 1, a bell-shaped form of horn, and refers to it as such in the specification (page 1, line 41), in referring to the drawing, there is nothing further in the specification descriptive of this particular construction, and it is not claimed in the claims. In other words, Nielsen's alleged invention, whatever it may be, is not restricted either in the specification or the claims to a bell-shaped or so-called "flower horn," but applies equally as well to any cone-shaped horn, or pyramidal form of horn. As the bell-shaped or "flower horn" was well known, and in vogue at the time that Nielsen filed his application for Patent, April 14, 1904, he very naturally, in describing his alleged improved construction, having the outwardly directed flanges  $b^3$  for forming the longitudinal ribs  $b^2$ , illustrated the said bell-shaped or "flower horn" in connection with his improvement. As far as any alleged invention of Nielsen's is concerned, he could just as well have illustrated his improvement by means of an ordinary conical horn "tapering in the usual manner," and it would have illustrated his improvement equally as well, and his claims of the

patent would have read upon the construction equally as well as in connection with the bell-shaped horn, which he did illustrate. As pointed out, and as admitted by counsel for plaintiff on argument, the bell-shaped horn formed of tapering curved longitudinal sections was not new with Nielsen. It was clearly prior art, among other places it was shown in the Villy U. S. Patent No. 739,954, issued September 9, 1903, reissued January 30, 1906, reissue patent No. 12,442, which Villy patents were owned by the plaintiff. (See Book of Exhibits Villy, original patent 739,954, page 56, etc.) It may be here again noted that the refusal of the Court to allow the Villy Reissue in evidence is one of the assignments of error in this case. (See Assignment III, Record, page 309, and Record page 128).

In describing the drawings, the Nielsen specification, page 1, line 40, refers to the illustration as bell-shaped, which it is in the drawings, and says, "The main part of the horn is bell-shaped in form and tapers gradually from the part a<sup>3</sup> to the larger or mouth end a<sup>4</sup>"; it then goes on continuing the description referring to the form just described, and says, "and this curve or taper is greater or more abrupt adjacent to said larger or mouth end."

It will be noted that this language is not descriptive of the **strips b**, themselves which go to make up the horn, but is merely descriptive of the illustration shown in Fig. 1, in which the invention is shown as embodied in this form of horn. Though, as before stated, a conical shaped horn would have illustrated the improvement of Nielsen equally

as well. So this language is not descriptive of anything that was invented by Nielsen, nor was it intended in the specification to be descriptive of the features of the invention.

How the horn illustrated embodied the improvement of Nielsen is then described, commencing at page 1, line 45, which reads as follows:

“The body portion of the horn is also composed of a plurality of longitudinal strips b, which are gradually tapered from one end to the other, and which are connected longitudinally so as to form longitudinal ribs b-2, each of the strips being provided at its opposite edges with a flange b-3, and these flanges of the separate strips are connected to form the ribs b-2.”

The specification then goes on to state that the body portion of the horn is composed of sheet metal strips b, which are stated to be “tapered from one end of said horn to the other.” (See claim 2), (and see pg. 1, lines 47-48). Nowhere in the specification are the longitudinal strips b, described as anything other than “tapering.” In other words, the metal strips b, are not described in the specification as **curved** along their edges, as shown for instance in the Villy Patent No. 739,954 (Book of Exhibits, page 58), where Fig. 3 illustrates the longitudinal sections forming the Villy bell-shaped “flower horn” as **curved** and tapering, which curve is necessary to give the bell-shaped effect of the Villy horn, shown in the Villy Patent. The Villy specification, page 60, line 57, in describing these sections illustrated in Fig. 3, going to make up the bell-shaped horn, states that they are “curved in such manner that although the segments when

opened out cannot lie in the same plane, they can either be folded together in a zigzag manner, so as to lie parallel to one another, as shown in Fig. 2 to 4, or extended by springing or buckling into the requisite trumpet or bell-like form, as shown in Figs. 1 and 5." The Villy specification also here states:

"The angles formed by a meeting of the hinged segments when extended form, as it were, ribs, giving rigidity to the trumpet form."

Nielsen, however, in his specification does not describe the edges of the metal strips as **curved**, but merely describes them as "gradually tapering from one end to the other." (Page 1, line 47).

Nielsen, very well knew that his improvement in his particular specific form of outwardly directed flanges, b-3, for forming the ribs b-2, could be applied to a conical-shaped horn, or a pyramidal horn, as well as to a bell-shaped horn, and did not restrict his claims to any particular form of these horns, as it was applicable to any of them.

Therefore, it is manifest that Nielsen did not consider that he was the inventor of a structure constituted of tapering strips having curved edges going to make up a bell-shaped horn, as **such shape of horn was old**, and well known at the date of his application for patent, April 14, 1904, as has been admitted by plaintiff's counsel at the argument in this case. It may be stated here in passing, however, this was not the position taken by plaintiff's counsel in the Court below, where it was contended strenuously throughout the proceedings

that Nielsen was the inventor of the so-called "flower horn," and to Nielsen was to be attributed all the popularity which the "flower horn" may have enjoyed for a period. This proposition is now, however, rejected, and it is clear that Nielsen was not the inventor of the flower horn, and to him is not to be attributed any favor or popularity with which the "flower horn" met.

That Nielsen intended that his alleged improvement of specifical longitudinal ribs formed of outwardly directed flanges b-3, should not be limited to the form of "flower horn" illustrated in the drawing, Fig. 1, or to any particular form of horn, conical, pyramidal, or otherwise, is further evidenced by the specification page 1, line 80, etc., where he says "changes in and modifications of construction described may be made without departing from the spirit of my invention, or sacrificing its advantages." It is clear that Nielsen's improvement, if it was such, resided in his particular construction of rib, and that its advantages, if there were any, applied to conical horns, or a pyramidal horns, as well as to "flower or bell-shaped horns."

**Claims 1 and 2 as Originally Filed and Issued  
Drawn Specifically to Nielsen's Particular  
Form of Ribs.**

It is significant that the first two claims originally filed, and as issued in the patent, specifically embody Nielsen's specific form of rib, or butt seam, constructed with the outwardly directed flanges

b-3. Narrower language could hardly be used in a claim to specify a specific form of construction than was used by Nielsen in these first two claims.

Claims 1, and 2 read as follows:

1. A horn for phonographs and similar machines, the body portion of which is composed of longitudinally arranged strips of metal provided at their edges with longitudinal outwardly-directed flanges whereby said strips are connected and whereby, the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs, substantially as shown and described.

2. A horn for phonographs and similar machines, the body portion of which is composed of longitudinally-arranged strips of metal provided at their edges with longitudinal outwardly-directed flanges whereby said strips are connected and whereby, the body portion of the horn is provided on the outside thereof with longitudinally-arranged ribs, said strips being tapered from one end of said horn to the other, substantially as shown and described.

Plaintiff's counsel has seen fit, for reasons best known to himself, to eliminate claim 1, from the case, and defendant is not charged with infringement of that claim. (See Record, page 65).

It will be noted that claim 2, which is alleged to be infringed, is in the identical language of claim 1, except that it has added before "substantially as shown," the words "said strips being tapered from one end of said horn to the other."

Claim 3 is also sued upon and reads as follows:

"3. A horn for phonographs and similar

instruments, said horn being larger at one end than at the other and tapered in the usual manner, said horn being composed of longitudinally-arranged strips secured together at their edges and the outer side thereof at the points where said strips are secured together being provided with longitudinal ribs, substantially as shown and described.

It will be noted that **none of the claims are restricted to a curved or bell-shaped horn**, and there are no limitations that the strips forming the body of the horn shall be curved; on the contrary, the strips are described only as "**tapered**."

Claim 2 would be anticipated by any conical, or pyramidal, horn having the longitudinally-arranged strips with the outwardly direct flanges forming the longitudinally-arranged ribs, the strips being tapered from one end of the horn to the other.

The claim would be anticipated by a conical, or pyramidal-shaped horn larger at one end than the other, that is "**tapered in the usual manner**," the horn being composed of longitudinally-arranged strips secured at their edges, and having longitudinal ribs provided at the point where the strips are secured together.

So there is nothing in these claims which shows that Nielsen had any intention of restricting them to a bell-shaped, or "**flower horn**," but he distinctly intimates that the construction may be applied to these other shapes, to the conical, or pyramidal-shaped horn, when he states that changes in and modifications of the construction described may be made without departing from the spirit of his invention, or sacrificing its advantages, (Record, page 1, line 80 to 83).

As already pointed out, the defendant's position is that it does not infringe claim 2, when properly construed, but that if broadly construed, claim 2 is clearly invalid in view of the prior article.

Plaintiff's position regarding claim 3 is that it is clearly invalid in view of the prior art.

#### **Unavoidable but Significant Admissions.**

Plaintiff's counsel, as already pointed out, admitted upon the argument in this Court that he does not contend that the bell-shaped or "flower horn" was new with Nielsen, and does not contend that the curved, tapering, longitudinal strips going to make up a bell-shaped or "flower horn," was new with Nielsen. He also admits, as he should, that the lock seam for uniting the longitudinal edges of metal strips going to make up a talking machine horn herein, was old prior to Nielsen, and well known in the art of the tinsmith, and the horn maker. It is difficult, therefore, to understand wherein any semblance of patentable invention resides, as all the elements were old, as well as the method of uniting the parts.

If plaintiff would come out frankly and admit that Nielsen's alleged improvement resided in his specific form of strengthening rib, consisting of the butt seam formed of the outwardly directed flanges, there might then, in view of these admissions, and of the facts as shown by the prior art, be some possible room for a very narrow invention, and narrow construction of claim 2, which fact perhaps, is the very reason which induced the patent office to grant the claim. Claim 3 is mani-

festly invalid in view of the prior art presented in this case, which prior art, however, was not before the patent office during the pendency of the application.

### **The Court Below Was of a Wrong Impression As to Nielsen's Alleged Invention.**

That the Court below was of a wrong impression in this regard is evidenced by the judge's statement during the trial (Record bottom of page 65, 66, etc.), where he stated: "My impression of this patent would be that the mere manner of forming that rib or joint is **not essential** to the patent, at all; that the essence of this patent is in the building of an instrument by strips of metal united together so as to make the whole, and that **it rests in the form of the horn**. The general form of the horn is constituted by strips which gives the horn this particular form and that is what they count upon.

This was an absolutely erroneous impression which the Court was induced to take by reason of the argument and statements of plaintiff's counsel in the Court below, though his position in the argument in the Court of Appeals was quite different. This impression as to the alleged invention was retained by the Court below throughout the trial and in its charge to the jury the Court was manifestly in error in charging the jury as to the scope of the invention (Record page 273). Among other things, when it instructed the jury in the essentials of the claims, that;

“4. The **strips** must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end.”

The Court had previously instructed the jury as to the tapering feature in paragraph 3 of the charge.

The Court also in describing the horn, instructed the jury that it had “substantially a bell-shape and by abruptly flaring outlet.”

It will also be noted that the Court further erred in instructing the jury, (Record, pg. 272) that the Nielsen horn must be composed of a “**multiplicity**” of strips—also that the strips called for in the claims must be of “**metal**.” The claims do not call for a “multiplicity” of strips, but merely use the word “**strips**” in the plural. Plurality is not necessarily a “multiplicity.”

Claim 3 makes no mention of **metal**, and does not require that the strips shall be of **metal**. The Court manifestly erred in also stating after thus describing the invention, “I instruct you that it clearly represents the invention as protected by the **claims** in issue of the Nielsen patent.

#### **Plaintiff's Attempt to Read Into the Claims a Requirement That the Strips Shall Be Curved.**

Upon the argument, plaintiff's counsel attempted to contend that the **curved** strips should be read into the claims 2 and 3 of the patent, because the specification, page 1, line 38, in describing Fig. 1, used the language, “this curve or taper is greater or more abrupt adjacent to said larger or mouth

end." His contention was that because the words "curved" or "tapered" were used in the connection referred to as that "tapered" should thereafter be construed as meaning **curved**. We have shown, he was merely referring to the drawing and that the word "tapered" as used in the specification could not be construed to include the word "curved." His argument also applied to claim 3 in this connection. That there is absolutely no foundation for any such a contention is manifest, without argument. The claims are specific in their language, and do not restrict the strips to being "curved," but merely limit them to being "tapered." If it had been intended to restrict these claims to "**curved**" strips, it certainly would have been so specified in the claims. There is perhaps no document, or portion of a legal instrument, which should be more concise and particular in the use of language than the claim of a patent, which fact is recognized by a long line of decisions, which it is unnecessary to cite. It could hardly be assumed that these claims with their various limitations would have been intended to have embodied restrictive features such as is implied with the word "curved" in connection with the strips when it is not so specified, and where nowhere in the specifications are the strips described or referred to as "curved."

Claim 2 requires that the **strips** shall be tapered from one end of the horn to the other.

Claim 3, among other things, requires that the horn shall be larger at one end than the other, and "tapered in the usual manner."

The longitudinally-arranged strips themselves in claim 3 are not specified as being "tapered" as in claim 2, but the horn itself in claim 3 is specified as being "**tapered in the usual manner.**" It is clear that "tapered in the usual manner" must mean what the words imply, that is a conical or pyramidal-shaped horn. What the applicant Nielsen understood by these words in the claims is evidenced by reference to the file wrapper.

#### BRIEF CONSIDERATION OF THE FILE WRAPPER.

The file wrapper is printed at page 170 to 183 of the record and shows that claims 1 and 2 as issued in the patent were filed with the original specification.

Claim 3 as allowed was subsequently incorporated, after sundry actions of the office and rejections of three other claims.

Original claim 3 (Record page 173, 174) was as follows:

"3. A horn for phonographs and similar machines, said horn being **tapered in the usual manner** and the body thereof on the outer side thereof being provided with longitudinally-arranged ribs, substantially as shown and described."

This claim was rejected by the patent office (Record page 175) on British Patent No. 20,557, of 1902, for graphophones (Book of Exhibits page 72 to 77) as well as U. S. Patent No. 181,159, of Aug-

ust 15, 1876, to Fallows, (Book of Exhibits, page 23). It was held, among other things, that it did not contain patentable invention in this claim to provide the usual tapered horn, or horn tapering in the usual manner with longitudinally-arranged ribs, especially in view of the longitudinal rib shown in the conical or tapering horn of the Tourtel British Patent (See drawing, Book of Exhibits, page 77), or in view of the transverse ribs shown in the Fallows U. S. Patent, No. 181,159. It will be here noted that the Patent Office by citing as anticipations references showing cone shaped horns clearly understood the words "tapered in the usual manner," as used in said rejected claim 3, to refer to a tapering conical-horn, such as shown in Tourtel British Patent, and Fallows U. S. Patent. The applicant then inserted an additional claim 4, which reads as follows. (Record, page 176):

"4. A horn for phonographs and similar machines, said horn being tapered in the usual manner and the body thereof on the outer side thereof being provided with longitudinally arranged ribs between which the longitudinal parts of the horn taper from one end to the other, substantially as shown and described."

This claim also claimed a horn "tapered in the usual manner," the body portion being provided on the outside with longitudinally-arranged ribs between which ribs the longitudinal parts of the horn tapered from one end to the other. The substance of this claim was a conical-horn tapered in the usual manner having longitudinal arranged ribs provided on the outside thereof in such a manner

that the spaces between the ribs tapered, though it was not stated to be composed of longitudinal strips. It will be noted that in the further conduct of the application, Nielsen's attorney merely contended that the Tourtel and Fallows references did not show horns for talking machines having longitudinally arranged ribs on the outside thereof, and that the Fallows reference only showed spirally-arranged ribs. He also stated (Record p. 176, 177), "It is the longitudinally-arranged ribs on the outside of the horn which produce the result claimed by applicant." No contention, however, is made to the fact that **both references showed conical horns**, and it is manifest that both the patent office and Nielsen's attorney clearly understood that a horn "tapered in the usual manner" as specified in the claims was such a conical horn as shown in both of the references.

Both of these claims were rejected in the next action by the patent office (Record page 177). In view of the patent Clayton, No. 612,639, of October 18, 1898, (Book of Exhibits p. 37 to 39):

An additional claim was then inserted (Record Book, p. 178), as follows:

"5. A horn for phonographic and similar instruments—said horn being larger at one end than the other and being composed of longitudinal tapered strips which are secured together at their edges, substantially as shown and described."

This construction called for a horn larger at one end than the other, composed of longitudinal tap-

ered strips, secured together at their edges, but did not embody the other features of the radially arranged ribs of the other claims.

Before action another claim was added, which subsequently became claim 3 of the patent. The Patent Office then again rejected claims 3, 4 and 5 as devoid of patentable invention in view of the patents previously cited, and in view of the Osten and Spalding patent, No. 705,126, of July 22, 1902. It was also held that to provide any horn with longitudinal stiffening ribs to render it less vibratory did not constitute patentable invention. Claims 3 and 4 were rejected on this ground as well.

The applicant then **acquiesced in the actions of the Patent Office** in rejecting these claims 3, 4 and 5, on the grounds stated, and in view of the references **showing horns "tapered in the usual manner"** and having the other features mentioned, and cancelled the said claims 3, 4 and 5 (Record, page 183).

It cannot very well be now contended by counsel in litigating the patent, that the words "tapered in the usual manner" as used in the claims as issued, mean anything else than what they were accepted to mean during the prosecution of the application for patent, or that the words "tapered in the usual manner" meant anything else than the tapered horns such as shown in the drawings of the British Tourtel patent, or in the drawings of the Fallows U. S. Patent (Book of Exhibits, p. 77, 24).

Plaintiff's counsel was also driven to the extremity in argument of contending that the words added to the claims "substantially as shown and de-

scribed"—the stereotyped phrase—read into the claims the **curved** feature. In the first place this contention is not warranted by the authorities; on the contrary, it is well settled that this stock phrase of patent solicitors cannot be the means of reading into the claims the specifications either for the purpose of holding infringement or of saving them from anticipation.

Further, if the words "substantially as shown and described" import into the claims the curved feature, as contended for by plaintiff,—they would also have like import as used in the rejected claims, which claims were rejected and the rejection acquiesced in by the applicant, and the construction thus admitted to be old.

But, as hereinbefore pointed out, there is **nothing in the specification which describes the longitudinal strips as being curved**, and, therefore, this phrase "substantially as shown and described" could hardly import into the claims something that was not in the specification.

It is also manifest from the foregoing consideration of the file wrapper, that **all the structures claimed in the rejected claims were old, and part of the prior art**, when the applicant acquiesced in the action of the patent examiner by cancelling the claims. Applicant therefore during the pendency of the application admitted that talking machine horns tapered in the usual manner, having longitudinally-arranged ribs on the outside thereof, and between which the parts tapered from one end to the other, was old and well known prior to the Nielsen invention; also that horns larger at one

end than the other composed of longitudinal tapered strips secured together at their edges were old and well known, and he cannot now after the issue of the patent be permitted to take any other position.

Claim 3 as allowed (Original claim 6) was doubtless allowed by the examiner, in view of the fact that he did not have before him the Villy patent No. 739,954, on September 24, 1903, which is in evidence in this case, nor did he have the benefit of other prior art now before this Honorable Court. It is manifest in view of the said prior art, that said claim 3 is invalid, and does not contain patentable invention.

Claim 2, narrowly construed to embody the specific form of outwardly directed flanges constituting the particular form of ribs may be valid, as embodying Nielsen's specific improvement, but this defendant does not use or infringe such a construction. If the claim is to be broadly construed, as contended for by plaintiff, it also is clearly invalid, and void.

#### **The "Flower Horn" for Talking Machines Old Prior to Nielsen.**

The Villy U. S. patent No. 739,954, issued September 29, 1903, for Horn for Phonographs, etc., invented by Gustave A. Villy, of Manchester, England, (Defendant's Exhibit O," Villy Patent, Exhibit Book, p. 57) shows what is styled in this case a "Flower horn," so called, doubtless, by reason of its morning glory, or flower effect. Plaintiff

endeavored in the court below to convince the court and jury that Nielsen was the inventor of the Flower horn (Record p. 46-47, etc.) This Villy patent is owned by the Searchlight Horn Company, the plaintiff in this case, though the plaintiff has not included this patent in its charge of infringement in this suit, and does not contend that this patent is infringed by the defendant.

This patent was subsequently reissued January 30, 1906, Reissue No. 12,442, with identically the same drawings and specification, the only difference being that it has **seven** more, and **broader** claims, added.

The plaintiff, the Searchlight Horn Company, prior to May, 1908, manufactured horns under this reissued Villy patent, No. 12,442, and marked the said horns with the said reissued patent, and also at the same time marked the same horns with the Nielsen patent, in suit, No. 771,441, of October 4, 1904, issued over a year after the date of the original Villy patent. (See also Record in Equity suit between these same parties, Appeal Case No. 2307, Affidavit of Wm. H. Locke, Jr., President of the plaintiff Company, pp. 48 and 51-52). Mr. Locke shows that the plaintiff Company, in November, 1906, sent out a circular notice ("Exhibit A," Equity Record 51-52) relative to these so-called "Flower horns," notifying the public that the plaintiff Company was protected by both these patents. This horn is first referred to in this Record, page 72, and marked for identification "Exhibit W," and subsequently marked as "Defendant's Exhibit T," (Record 203); and was manu-

factured by the plaintiff Company as shown by Mr. Locke's testimony (Record p. 89). Mr. Locke here testified that this horn was the product of the Searchlight Horn Company. It is referred to at this portion of the record as marked for identification "Z." This is a typographical error; it should be "W." It was subsequently marked and known as "Defendant's Exhibit T." 500 were sold by the plaintiff to the defendant (see Record p. 84).

#### Refusal to Admit the Villy Reissue Patent in Evidence.

This flower horn "Exhibit T" (Record 203) was marked by the plaintiff as constructed under the Villy re-issue patent, and also marked as containing the construction of the Nielsen patent in suit, No. 771,441, of October 4, 1904. Notwithstanding this fact, the Court below refused to admit in evidence the reissued Villy patent No. 12,442, of January 30, 1906, to which an exception was properly noted. (See Assignment of Errors III). This patent should have been admitted in evidence, as it seems an important **connecting link**, and is significant, and shows that the reissue marked on these horns made by the plaintiff was a reissue of the original Villy patent, No. 739,954, of September 29, 1903, and contains the same drawings and the same specification, differing only in the addition of seven broader claims.

The admission in evidence of the Villy Reissue Patent would thus show that the patent noted on the horn is the same as the Villy patent No. 739,-

954, and is a reissue of that earlier patent, which patent embodies the chief characteristics and features of the Nielsen patent in suit.

When plaintiff marked, as it did, on its flower horn "Exhibit T" the word, "Patented" with the dates of both the Villy reissue patent No. 12,442 and the Nielsen patent No. 771,441, it notified the public and admitted that the said horn, "Exhibit T," was constructed under both patents. It was manifest that the later Nielsen patent could only embody such features of invention as were not embodied in the prior original Villy patent.

**Features and Characteristics of the Original Villy  
Horn Patent, No. 739,954, Issued Sep-  
tember 29, 1903.**

An examination of the specification of this patent is helpful in this case, in that it shows that the Court below erred in its construction of the Nielsen patent in suit by attributing to the Nielsen patent as characteristic of that patent essential features which were the characteristic of the Villy patent, and were fully described in the Villy patent. The Court, therefore, in instructing the jury as to the scope of the Nielsen patent, erred, and misled the jury into an erroneous verdict. The Court, as before stated, in the trial of this case, expressed its understanding of the invention in the Nielsen patent, as follows (Record 65-66):

"My impression of this patent would be that the mere manner of forming that rib or joint is not essential to the patent at all; that the

essence of this patent is in the building of an instrument by strips of metal united together so as to make the whole, and that it rests in the form of the horn. The general form of the horn is constituted by strips which gives the horn this particular form and that is what they count upon."

In other words, the Court seemed to have the impression, from the foregoing, that the flower horn effect was due to the Nielsen invention, and that the method of curving the strips so as to form the bell shape effect was an essential characteristic of the claims. As hereinbefore pointed out, the Court was in error in instructing the jury as to the essential characteristics of the claims of the Nielsen patent when it said *inter alia* (Record p. 273):

"The strips must curve outwardly from the inner to the outer end, but the curve is more abrupt adjacent the outer end."

The Court also instructed the jury that Nielsen by combining the elements claimed produced a horn "having substantially a bell-shape and abruptly flaring outlet." The Court then also stated: "I instruct you that it correctly represents the invention as protected by the claims in issue of the Nielsen patent."

Claims 2 and 3 do not call for this construction, and Nielsen did not invent it.

A careful reading of the Villy U. S. patent No. 739,954, will show that this 'flower horn' formed by these tapers strips so curved as to give to the resultant horn the bell shape effect was one of the features of and disclosed in this Villy patent.

Villy describes very carefully how he curves the strips in order to secure in the resultant horn the

bell-shape and curved and tapering effect, and the language descriptive of the commercial Searchlight Horn, "Exhibit T," as set forth in the Circular to the Trade of November 15, 1906, produced by Mr. Locke, President of the Company, in the Equity Proceedings, between these parties (Appeal Case No. 2307, pp. 48, 51-52), hereinbefore referred to, was practically taken from the Villy patent; the circular also refers to the longitudinal ribs of the Nielsen patent. (See cut, p. — of this Brief). It is true that the Villy flower horn was also a collapsible or folding horn, but that fact made no difference as far as these features are concerned.

Therefore, when Nielsen came into the field, over a year after the date of the issue of the Villy patent, all that he could claim at best was some specific construction over the Villy horn and the prior art.

Horns for talking machines, prior to the Nielsen application of April 14, 1904, made from strips were legion, as shown not only by the record in this case, but by the record in the equity suit, (Appeal Case No. 2307), against Sherman, Clay & Company, and by the record in the equity suit before this Honorable Court on this Calendar for alleged infringement of the same patent, in the case of Pacific Phonograph Company, Appellant vs. Searchlight Horn Company, Appellee.

Still following, and referring to the Villy patent No. 739,954, of September 29, 1903, we find that the flower shape horn, shown in Figs. 1 and 5 of the drawing, is fully described as to how the **trumpet like curve, configuration and bell shape mouth or**





“Defendant’s Exhibit T.” (marked also for Identification “W.”)

form is given to it by the flexible segments, or tapered strips **b**, which are each **curved** in such a manner that although the segments when opened out cannot lie in the same plane, they can either be folded together in a zig-zag manner, as shown in Figs 2 and 4, or extended by springing or buckling into the requisite trumpet or bell-like form, as shown in Figs. 1 and 5 (See specification, page 1, lines 55, etc.), and as illustrated by Defendant's Exhibit T. The specification then goes on and states (lines 64, etc.); "The angles formed by the meeting of the end segments when extended **form, as it were, ribs, giving rigidity to the trumpet form.**" The specification describes how the tapering strips, or curved segments, are preferably hinged together to form a hinge-like connection, **c**, by being secured upon a base of linen, or like connecting web, upon which the tapering sections, or segments, are mounted. The material of the flexible sections is, (as stated in the specification, page 1, lines 43, etc.) of paper, wood, linen, "or other preferable flexible material."

The cut appearing on the opposite page is a picture of "Defendant's Exhibit T" (Record 203) previously marked for identification as "Exhibit W" (Record 72,) and is the commercial horn put out by the plaintiff, the Searchlight Horn Company, about 1906, marked as constructed under both the Villy Reissue patent of January 30, 1906, and the Nielsen patent in suit of October 4, 1904—the Villy reissue, No. 12,442, as

before pointed out, being the reissue of Villy original patent No. 739,954, of September 29, 1903. The plaintiff here, by so marking this horn and giving notice to the public that it was patented under these two patents, is **estopped** from denying that the Villy horn of the patent No. 739,954, and the reissue No. 12,442, **may be made of thin flexible metal** of which the strips of this Exhibit Horn T, placed on the market by the plaintiff Company, are made.

Plaintiff's counsel has contended that the Villy horn was a paper horn, not metal—but plaintiff's own acts in making it of **metal** and marking it with the Villy Reissue Patent negatives any such contention. This commercial horn also goes to show that the plaintiff, the Searchlight Horn Company, admits that it could make the metal tapering strips of a greater length than shown in Fig. 1 of the Villy patent, as desired. It further goes to show that the plaintiff admits, by putting this horn on the market as made under these two patents, that the tapering sections of the Villy horn may be united by other hinge joints than linen, or like flexible material, and may be joined by **metal rib hinges** with a metal rod inserted therethrough.

This Exhibit also goes to show that the plaintiff, in putting out these horns as made under the two said patents, the Villy patent and the Nielsen patent in suit, admits that the said Villy construction of the reissue patent, issued June 30, 1906 (which is a reissue of the Villy original patent No. 739,954, and antedates the Nielsen invention) embodied all these features of the Villy patent, and that only

what is left after Villy constitute the features of the Nielsen patent in suit.

What is left for Nielsen over the Villy construction is, it must be admitted, but little. It would appear, if anything, to be the raised ribs uniting every other tapering section of the horn, which also forms the hinge joint for these two sections. It is difficult to see what else is left in this "Defendant's Exhibit T" embodying any feature of the Nielsen patent.

It does not lie in the mouth of the plaintiff to deny that in this exhibit, "Defendant's Exhibit T" (Record 203), the said Villy patent of January 30, 1906, is embodied, and also, as stated, the said features of the Nielsen patent of October 4, 1904, as plaintiff had clearly marked the patents upon the said exhibit. Further, as hereinbefore pointed out, the affidavit of Mr. Locke, President of the Company, in the Equity Suit on Appeal, Case No. 2307, between these parties admits that the said "Searchlight Horn" is protected by the said Nielsen patent No. 771,441 of October 4, 1904, and the Villy reissue patent No. 12,442 of January 30, 1906, in his affidavit, and circular attached thereto (Equity Record 48, 51 and 52).

We have already pointed out that the Villy patent (specification p. 1, lines 64, etc.) refers to the ribs at the angles formed by the meeting of the hinge segments when extended giving "rigidity to the trumpet form." The Villy patent No. 739,954 also states (page 2, lines 51, etc.): "My horn, owing to the curvature of the edges of the strips is self-sustaining and requires no additional stiffening

or sustaining devices, —.” Of course, the “Searchlight Horn” shown in “Defendant’s Exhibit T,” illustrated in the last cut could not be said to embody claim 2 of the Nielsen patent in suit, as that calls for the specific form of rib illustrated in the drawings and described in the patent, which is not embodied in this exhibit, though it may come within the language of claim 3, broadly considered, which claim so construed, we contend, however, is invalid.

Want of patentable novelty is very well illustrated by this plaintiff’s “Searchlight Horn,” “Defendant’s Exhibit T,” when we consider the structure hereinbefore pointed out. All the necessary features going to make up a complete horn are present in this exhibit, and practically nothing is left in this exhibit to constitute the structure of the Nielsen claims. In other words, we have in this exhibit a complete embodiment of the Villy invention, and it requires **all that is there embodied to make up the Villy completed horn.** The Nielsen patent, therefore, as far as this exhibit is concerned, is negligible as there can only be found in it any semblance of the Nielsen construction **by utilizing over again the elements necessary to make up the Villy construction.** The most which could be said in favor of the presence of the Nielsen construction in this “Defendant’s Exhibit T” is that the **hinge joints** uniting the outer edges of every other tapering section going to make up the horn are **raised in the form of a rib.** Villy does not limit himself to the linen base for forming the hinges **c**, but states (page 1, line 64): “The angles formed

by the meeting of the hinged sections when extended form, as it were, **ribs**, giving rigidity to the trumpet form." He also states (page 2, lines 68, etc.):

"I do not limit the application of my invention to any particular method of building up the segments or to any special curve or configuration of the same, and I vary the method of jointing and stiffening them to suit the material from which the strips are constructed and the foundation or base fabric upon which the flexible material forming the strips is secured."

So that, as a matter of fact, there is little, or nothing, left for Nielsen in this construction, and we submit **certainly nothing patentable**.

**Nielsen Suggests Uniting the Edges of the Longitudinal Strips of the Villy Construction  
By Upturned Flanges.**

The most that could be said for Nielsen is, that he suggested that the tapering curved sections of the Villy horn could be united in a non-collapsible horn by providing the edges of the strips with **longitudinally outwardly directed flanges** which, when united, constitute longitudinally arranged ribs. These flanges in the Nielsen patent being marked **b<sup>3</sup>**, as shown in Fig. 4 of the Nielsen patent, when they abut and are secured together form the outwardly extending ribs **b<sup>2</sup>**, shown in section in Fig. 3 of the Nielsen patent. If there is any spark of ingenuity of a patentable character to be recognized in this construction, claim 2 might be sus-

tained for such a narrowed specific construction, but claim 3, which if read broadly enough to include any method of securing the tapering sections together at their edges, and thus to provide longitudinal ribs, or seams, of any character by such a union, would manifestly lack all semblance of invention, in view of the Villy patent, and in view of the common practice, long prior to the Nielsen invention of October 14, 1904, of uniting metal sections in tapering talking machine horns, among other things.

#### THE VILLY FLOWER HORN NOT RESTRICTED TO COLLAPSIBLE HORNS.

That this was the clear understanding of the Searchlight Horn Co. is evidenced by the affidavit of William H. Locke, Jr., President of the company in the equity proceedings against this defendant (Appeal Case No. 2307), (Record pp. 45 to 51), and in the Exhibit A, a circular letter to the trade, of November 15, 1906, attached to that affidavit (Record pp. 47, 48, and 51, 52), stating that the Searchlight horn was protected by the Nielsen Patent, No. 771,441, of October 4, 1904, and the Villy Re-issue Patent, No. 12,442, of January 30, 1906. It stated "all of the so-called 'Flower Horns' made by our aforesaid competitors are **flagrant infringements** of said patents." See notice of November 15, 1906 (Equity Record pp. 51 and 52). As none of the competitors made the **folding horns** this is tantamount to a statement that the Villy invention did not have to be a folding horn. This circular, in re-

ferring to the construction of the so-called "Flower Horns," quotes claim 8 of the Villy Reissue Patent, of January 30, 1906, (which the court below refused to admit in evidence, and which we contend was manifest error, p. 309). This claim 8 has no reference to the collapsible feature of the Villy horn, and is one of the 7 broader claims added to the reissue of the Villy patent, for which purpose the original Villy patent, No. 739,954, was reissued in Patent No. 12,442, and only for this purpose to add these 7 additional broader claims, which include the flower horn, **irrespective of any collapsible feature**, and whether collapsible or rigid.

The circular also includes the claim 3 of the Nielsen patent, but this circular significantly points out the fact that the position of the Searchlight Co. in regard to the Villy Reissue Patent was that with these 7 new claims broadly drawn, the said patent covered the Flower Horn made with the tapering strips formed, curved and united to give the tapered, trumpet-like and bell-shaped form, whether the horn were collapsible or non-collapsible, and the circular was sent, as shown by Mr. Locke's affidavit, to the trade shortly after the reissue No. 12,442, in 1906, to dealers and manufacturers who were making or selling horns similar to the defendant's infringing horn in this case, such as shown in "Plaintiff's Exhibit No. 15," etc.

**When U. S. Horn Company Abandoned the Nielsen  
Flange On Its Horns, It Sought to Secure  
Broader Patent Protection by Reissuing  
the Villy Patent.**

The U. S. Horn Company, the plaintiff's predecessor, evidently considered that the Villy bell-shaped horn was not limited to a collapsible horn, and covered a non-collapsible construction as well, as after the issue of the Nielsen patent in suit, it applied for a reissue of the Villy original patent October 26, 1905, and secured the Reissue No. 12,442, with seven broad additional claims, eliminating the collapsible feature from these claims, and making them broad enough to include the horn which **Mr. Krabbe says the U. S. Horn Company was making at that time.** Exhibit 9 (Record p. 42-43). It should be noticed here that Krabbe's testimony, as well as Mr. Locke's shows that they first made quite a number of horns such as plaintiff's Exhibit 10 in 1904-5, with the outwardly directed flanges constituting the ribs or butt seams as described and claimed in the Nielsen patent, but that they gave up this construction of flange as it had to be soldered and was more expensive to make (Record p. 42-43). They then went back to and adopted the **old lock seam** in their subsequent horns—such as plaintiff's Exhibit 11, etc. and **never again made this specific rib or flange of Nielsen.** They then in October 26, 1905, applied for a reissue of the Villy Patent, No. 739,954, the Nielsen flange being of little use to them under these circumstances, in order to secure broader claims to cover the horn

they were then making. Claim 8 of the Villy Reissue is a fair example of the said claims then secured, viz:

“8. A phonograph-horn or the like comprising a number of flexed strips having curved meeting edges, and means joining said edges, said strips being so flexed and said edges so curved and joined that the horn is given a trumpet-like or bell-like form, the strips forming angles where said edges meet.”

This reissue patent 12,442 of January 30, 1906, was then marked by the plaintiff upon its horns, together with the date of the Nielsen patent in suit. Plaintiffs made about 3,000 or 4,000 of these particular horns like Exhibit T, marked for identification “W” (Record, p. 84). They also, as herein pointed out, notified the trade by circular letter of November 15, 1906, that the various manufacturers were infringing their said Villy and Nielsen patents, specifying in the said circular letter as the infringement complained of, among other things this claim 8 of this Villy patent.

There is no explanation in this case why the Searchlight Co. did not sue the defendant upon the Villy Reissue Patent, instead of the Nielsen patent, but the plaintiff doubtless had its reasons.

**Ribs to Secure the Edges of Longitudinal Sections  
of Talking Machine Horns Used Many Years  
Prior to the Application for the Patent  
in Suit.**

It is hardly necessary to elaborate this proposition, which must be admitted and recognized. As an illustration, however, we would refer to "Defendant's Exhibit Tea Tray 20-inch Brass Horn," of which the cut appearing on the opposite page is a photograph.

Horns of this construction were made as early as 1892-1893, for talking machines by The Tea Tray Company (Record 131).

This not only illustrates the seam and method of uniting the horn sections by lock seam, or rib, but it answers all the terms of claim 3 of the Nielsen patent, if it is to receive a broad construction, as well as claim 2 if broadly construed. It is true that it is not a so-called "flower horn," but claim 3 is not limited in its requirements to a flower horn, as before pointed out. Referring to claim 3, this exhibit horn, above illustrated, made in 1892-1893 it is not disputed is a horn for talking machines larger at one end than at the other, and tapered in the usual manner. The horn is composed of longitudinally arranged strips (only two strips, however, instead of a multiplicity, but the claim does not require a multiplicity) and said strips are secured together at their edges by a lock seam, and the outer side thereof at the point where the strips are secured together are thus provided with longi-



Defendant's Exhibit, Tea Tray 20-inch Brass Horn

plaintiff's counsel being that in a talking machine horn the walls of the horn tend to vibrate as the sound comes through it, which impairs the reproduction. This vibration, was styled "tintinnabulation," and plaintiff's counsel contended that the metal ribs of the Nielsen patent tended to prevent this vibration. Plaintiff's counsel also endeavored to bring out some function of this character through plaintiff's expert, Baldwin Vale (Record 105, etc.). It is apparent, however, from the cross-examination (Record 113) that he bases this theory entirely on lines 71, etc. of the Nielsen patent, which merely states that the "said ribs serving to do away with the vibratory character of the horns of this class as usually made and doing away with the metallic sound produced in the operation thereof." This is a **somewhat crude statement without any explanation as to the operation**, and, as a matter of fact, was not by any means a new thought with Nielsen. If there is anything in it at all, it was previously suggested in some of the prior art, before fully considered at pp. —— of this brief. No other witness than the patent expert Vale was produced to prove the alleged fact that any better results were obtained by the use of Nielsen's ribs, and **no tests were made**. Witness Vale was not proven to be an expert in the talking machine art, and his testimony can have but little weight.

The theory of plaintiff in this record is that by putting in these ribs or insulations, the vibration is broken up, but when the whole begins to vibrate the vibrations go toward the joints, and this vibration will then cease. If this theory is correct, then

we have again the same effect as in the prior Villy patent, No. 739,954, where the longitudinally tapered sections are separated from each other, and insulated as it were by the intervening joint *c*, which was of linen, or some other connecting web, as the patent states: "I vary the method of jointing and stiffening them to suit the material from which the strips are constructed." Therefore, if plaintiff's theory is correct, Villy destroyed this "tintinnabulation," if such a thing existed, by separating or insulating his longitudinal tapering sections, and while he may not have described this feature, if it was a feature, it was manifestly present from plaintiff's own theory. In a sister suit on the same patent against the Pacific Phonograph Company, now on appeal before this Honorable Court, Case No. 2314, defendant's witness, E. A. Hawthorne, a manufacturer of talking machine horns of wide experience for many years past states, page 65:

"It is my opinion, based upon many tests, and long experience, that there is no difference in the sound producing qualities of a horn, whether of metal or other material, resulting from the use of one longitudinal rib and from the use of two or more longitudinal ribs. I attribute the perfection of the sound-producing qualities of a horn to its length (and inside cubical dimensions) and not at all to any longitudinal ribs with which it may or may not be provided and not at all to the thickness of the material of which the horn may be constructed."

In U. S. patent to Saxon No. 72,422, issued December 17, 1887, in evidence in the present suit (Exhibit Book p. 89) the **increasing** of tintinnabulation is claimed to exist by providing longitudinal ribs in the outer walls of a flaring glass bell-shaped instrument used as a bell. The contrary of the plaintiff's theory.

It is respectfully submitted that this alleged minimizing of the vibratory character of the horn through the medium of ribs, if there is any merit in it, is not sufficiently proven, and we believe we have proved, was, at all events, not new with Nielsen.

As elsewhere pointed out herein, the Osten & Spaulding U. S. Patent, No. 705,126, of July 22, 1902, (Book of Exhibits, p. 45 etc.), clearly discloses this theory of Nielsen's showing their ribs on their horn was for the same purpose (See pg. 46, lines 73-88).

**Re-extensive Use of Flower Horn—Manifest Error  
of the Court In Its Instructions as to the  
Law in Doubtful Cases.**

The plaintiff contended in the court below, that the flower horn had become, prior to the date of the alleged infringement, very popular, and that quite a number had been sold to the trade. There is no evidence, however, that the popularity of the **Searchlight Horn**, if it met with any particular favor, was due to anything which Nielsen had invented, as it is clear, as hereinbefore specifically pointed out, that the construction which gave the

horn the flower effect was due, not to anything that Nielsen had invented, but was due to the Villy Patent, No. 739,954 of September 29, 1903, subsequently reissued January 30, 1906, and which patent date was stamped upon the horns put out by the Searchlight Co., such as Defendant's Exhibit T (Record p. 203). It is respectfully submitted, therefore, that if there was any popularity manifested for this horn such as put out by the Searchlight Co. it is not shown by the plaintiff to have been due to anything that Nielsen invented, but is manifestly due to Villy, who had long prior to Nielsen patented and described the features of the flower horn.

#### **Re Evidence of General Use in Doubtful Cases.**

We also submit that the court was in error in its charge to the jury, among other things, where it stated (Record pp. 274-275), that in **doubtful cases** where the patent has gone into general use and superseded prior devices for the same purpose, this fact is **sufficient evidence to justify the jury** in deciding that the patent involves invention, and it is valid. This charge is also erroneous in that, among other things, it assumes that the alleged general use of the flower horn was due to the Nielsen patent, of which there is no evidence. This portion of the charge is manifestly erroneous, as not good law, and not supported by the authorities. The charge is:

“That rule is that **in a doubtful case**, if it appears by the evidence that the patented device has gone into general use and has super-

sed prior devices having the same purpose, that fact is sufficient evidence of invention, and will justify a jury in deciding that the patent involves invention and is valid."

This is not the rule of law that the fact that a patented device has gone into general use and superseded prior devices in doubtful cases "**is sufficient evidence of invention**," to justify the jury in deciding that the patent involves invention and is valid. Such facts are not sufficient evidence of invention to warrant such a finding, but are to be used as **persuasive** in doubtful cases. The impression created on the mind of the jury by such a charge is doubtless that it was "**a hard and fast rule**" that where the patented device had gone into general use, and superseded prior devices that fact is sufficient evidence of invention and binding upon the jury to decide that the patent involved invention. The law in the matter, as decided by numerous authorities, is to the effect that it may be used as **persuasive**, though there are many cases where this test cannot be applied, as where the general use of the device is due to sundry other causes, such as **printer's ink, and present day methods of advertising, etc., or the presence of another prior invention in the device.**

The court might have properly said in this case that if they believed that the plaintiff's device had gone into general use and superseded all other devices, that it was strong or persuasive evidence of invention, but when it said that it was **sufficient**, we think a fatal error was committed.

In the case of Voightmann v. Weiss & Ridge Cor-nice Co., 133 Fed. 298, 304, the court said:

“No extent of use can supply the want of actual invention or cure the vice of mere aggregation. Adams v. Bellaire Stamping Company, 141 U. S. 539, 35 L. Ed. 849; Lehigh Valley R. Co. v. Kearney, 158 U. S. 141, 39 L. Ed. 100; Grant v. Walter, 148 U. S. 547, 37 L. Ed. 552. This is well summed up by Mr. Justice Brown in McClain v. Ortmayer, 141 U. S. 420, 35 L. Ed. 800.”

In Hotel Security Checking Co. v. Lorraine Co., 155 Fed. 298, the court said:

“In view of the foregoing, the asserted extensive use into which the device has gone and the large amounts in royalties that have been paid to complainant cannot be considered as giving the device patentable novelty. Upon this point, the adjudications uniformly hold that, where there is no invention, the extent of the sales and use of the patented article is immaterial. Adams v. Bellaire Stamping Co., 141 U. S. 539; Peoria Target Co. v. Cleveland Target Co., 47 Fed. 725; Olin v. Timken, 155 U. S. 155.”

In the case of Tubelt Co. v. Friedman, 158 Fed. 430, 439, the court said:

“Its greater utility, durability, attractiveness, and marketability do not of themselves show patentable novelty. These facts are evidence on the subject, and in very doubtful cases may be persuasive and turn the scale in favor of the patentability of the device. A valid patent must combine utility, novelty and invention. Neither large sales nor pop-

ularity nor effectiveness of itself shows patentable invention. Nor do all these combined establish it." See *Duer v. Corbin Co.*, 149 U. S. 216; *Richards v. Elevator Co.*, 159 U. S. 477, 487; *American Sales Book Co. v. Bullivant*, 117 Fed. 255, 54; *McClain v. Ortmayer*, 141 U. S. 419, 429, 35 L. Ed. 800; *Union Biscuit Co. v. Peters*, 125 Fed. 601, 609; *Falk Mfg. Co. v. Missouri R. Co.*, 103 Fed. 295; *New Departure Bell Co. v. Bevin Bros. Mfg. Co.*, 73 Fed. 469; *Dodge Coal Storage Co. v. N. Y. et al.*, 150 Fed. 738."

In the case of *McClain v. Ortmayer*, 141 U. S. 419, the court said:

That the extent to which a patented device has gone into use is an unsafe criterion even of its actual utility, is evident from the fact that the general introduction of manufactured articles is as often effected by extensive and judicious advertising, activity in putting the goods upon the market, and large commissions to dealers, as by the intrinsic merit of the articles themselves. While this court has held in a number of cases, even so late as *Magowan v. New York Bel. et al.*, 141 U. S. 332, decided at the present term, that in a doubtful case the fact that a patented article had gone into general use is evidence of its utility, it is not conclusive even of that, much less of its patentable novelty." The same rule is applied in *Lovell Mfg. Co. v. Carey*, 147 U. S. 623.

In the case of *Adams v. Bellaire Stamping Co.*, 141 U. S. 539, the court said:

"Nor under the circumstances did the court err in declining to instruct the jury that the fact that

the Irwin lantern had practically superseded all others was strong evidence of its novelty. The question before the court upon the main issue was not of the novelty of the invention, but rather of its patentable character. Where there is no invention the extent of the use is not a matter of moment."

The court may not care to examine all of the cases cited, but we call particular attention to *McClain v. Ortmayer*, 141 U. S. 419-29. We have cited many of the cases, to show to the court, that by an unbroken line of decisions, the courts have stood by the proposition that evidence that the patented device had gone into public use and superseded other prior devices might be under proper circumstances, evidence of utility and some evidence of novelty, but on the contrary, that it is never to be considered as a cold matter of law, **sufficient** evidence of invention, or novelty, and that it was erroneous for the court to so instruct the jury.

If the alleged popularity of the plaintiff's horn made prior to the alleged infringement was due to the specific features of the Nielsen Patent, it was incumbent upon the plaintiff, especially in view of the proofs, to have shown this fact; this is especially true where the plaintiff itself puts upon the market a horn such as "Defendant's Exhibit T," marking it with the date of **both the Villy and the Nielsen Patents**. In the absence of such proof, it was erroneous on the part of the court below to assume that the popularity was due to specific features of the Nielsen Patent, and the court was in

error in charging the jury as it did, thereby leading to an erroneous verdict.

### **Career of Plaintiff and Predecessors One of Failure, Not Success.**

Evidence of the fact that these Flower Horns, at best, were not so very popular as manufactured by the Searchlight Co., is the fact that the Searchlight Co. as shown by plaintiff's proofs (Krabbe Testimony, Record p. 80-81, etc.) was so unsuccessful that it was obliged to go out of business after an attempt of a year or two to place the horns upon the market. This is true also of its predecessor, the U. S. Horn Company.

### **No Proof That the Defendant, Sherman, Clay & Co. Ever Sold An Infringing Horn.**

In May, 1908, the Searchlight Co. went out of business as a manufacturer (Record p. 81) and made an arrangement with the Standard Metal Manufacturing Co. to manufacture these horns (Record p. 82, testimony of W. H. Locke, Jr., President of the Searchlight Co.). The Searchlight Co. turned over its machinery to the Standard Metal Manufacturing Co. of Newark, N. J., in May, 1908, for this purpose, and the arrangement was to divide the profits (Record p. 83). The Standard Metal Manufacturing Co. then supplied the entire market, including the defendant herein, after the arrangement (Record p. 83), and the Searchlight Co. ceased to manufacture, and has not manufactured since the arrangement with the Standard

Metal Manufacturing Co. and is now having its said goods marketed by the Standard Metal Manufacturing Co. (Record, bottom p. 84 and 85). The testimony of Mr. Locke, President of the Searchlight Co., also shows (page 85) that the Standard Metal Manufacturing Co. since the arrangement with the Searchlight Co. has manufactured most of these horns, which are the alleged infringing horns, which the Victor Talking Machine Co., supplied to the defendant in this case.

We would note again in passing here, that there is no evidence in this case that any of the alleged infringing horns sold by the defendant were purchased by the Victor Co. prior to the date of the license to the Standard Metal Manufacturing Co. The president of plaintiff's company admits that most of the alleged infringing horns were bought by the Victor Co. from the Standard Metal Manufacturing Co., the plaintiff's licensee, and if there was any contention that any of the alleged infringing horns were purchased by the Victor Co. from the Tea Tray Co., the **onus**, under the circumstances, was upon the plaintiff to prove such alleged fact. The President of the plaintiff company, Mr. Locke (Record p. 85), testifies as follows:

“I understand that most of the horns are manufactured by the Standard Metal Manufacturing Company but the Tea Tray Company **may** make some of their horns.

Q. For the Victor Talking Machine Company?

A. Yes.”

Even here there is no proof that the horns sold

by the Tea Tray Company to the Victor Company were alleged infringing horns. The Victor Company bought and sold many kinds of horns.

If the **onus** had been upon the defendant previously relative to license, the testimony of the President of the plaintiff company proves license, and by his testimony shows that most of the Victor horns were manufactured since May, 1908, by its licensee, the Standard Metal Manufacturing Co., but some horns of some kind may have been made by the Tea Tray Co. The **onus** then is upon the plaintiff, if it contends that any of the alleged infringing horns were sold by the Tea Tray Co. to the Victor Company to prove that alleged fact.

#### **The Entire Business of the Plaintiff Turned Over to the Standard Metal Manufacturing Company—Further Considered.**

The plaintiff may contend that the arrangement with the Standard Metal Manufacturing Company only related to the **folding** horns, as was contended by the Court below. That this is not the fact, and that the Searchlight Horn Company turned over its **entire business** and machinery and dies which it had previously used in the manufacture of its talking machine horns, including the manufacture of horns which it had previously made, such as shown in Plaintiff's Exhibits 9, 10, 11 and 12, is clear from the plaintiff's evidence. Let us consider the evidence somewhat more in detail.

The Searchlight Company, according to the testimony of President Locke, had made and sold some

35,000 horns prior to May 8, 1908, when it turned over the business to the Standard Metal Manufacturing Company (Record, p. 79); of which horns only 3000 or 4000 were folding horns like Defendants' Exhibit T (prior marked W for identification) (Record, p. 84). The plaintiff's testimony is to the effect that its predecessor in business, the U. S. Horn Company, had previously "captured the market" with horns, such, for instance, as shown in Plaintiff's Exhibit 12 (Record, p. 77). Plaintiff's testimony also shows that every horn put out by it, or it's predecessor, the U. S. Horn Company, had been marked with the Nielsen patent (See Krabbe testimony, Record, p. 48). It might be stated here that the evidence shows that William H. Locke, President of the Searchlight Company, and Christian Krabbe, plaintiff's principal witnesses, first individually acquired the Nielsen patent, as well as the Villy patent, and organized the first company, the U. S. Horn Company, which made some horns, and was **unsuccessful**, and then organized the Searchlight Company, the plaintiff, turning over the business to it, which Searchlight Company was also **unsuccessful**. (Record p. 39-40, etc.). Mr. Krabbe, who was a tinsmith, and dealt in electrical supplies, is said to have acquired the Nielsen patent from Nielsen on February 5, 1905; he then conveyed a one-half interest to Mr. Locke on February 14, 1905 (Record, p. 40), and they then started a company, which they called the U. S. Horn Company, and they employed Nielsen at \$2.65 a day (Record, p. 40). They first made the horn like Plaintiff's Exhibit

10, with the straight flange or butt seam, such as shown in the Nielsen patent, and which was similar to the horn which Nielsen first showed them (Record, p. 42). Mr. Krabbe then shows that the U. S. Horn Company subsequently changed the construction of the flange from the specific form of the Nielsen flange and turned over the edges in the nature of a lock-seam, as shown in Exhibit 9 (Record p. 43). That this was cheaper, and they did it as there was considerable competition, and "because every little tinsmith was trying to make them." The blue horn was Exhibit 10, and the red horn was marked Exhibit 11.

**Nielsen Leaves the Employ of the U. S. Horn Company Shortly After It Abandons Making His Flanges and Ribs on Its Horns.**

Nielsen only stayed with the U. S. Horn Company from four to six months, and left shortly after they abandoned Nielsen's outwardly directed flanges for forming the rib, and started to make the red horn with the turned-down flange similar to Exhibits 11 and 12. (Record, p. 43, 44). The Searchlight Horn Company took over the business of the U. S. Horn Company after it was unsuccessful, which was about the latter part of 1906, or the early part of 1907.

The Searchlight Horn Company only continued in business until May 8, 1908, when it found the business to be unprofitable, and ceased then to do business, and turned over all its business and machinery, dies, stock, etc., to the Standard Metal Manufacturing Company (Locke testimony Record, p. 81 to 83, etc.)

It will be remembered that Plaintiff's Exhibits 14 and 15 were introduced to show the alleged infringing horns. Exhibit 14 is a 23-inch horn, and Exhibit 15 is a 19-inch horn. Mr. Locke's testimony (Record, p. 82) shows that the plaintiff's arrangement with the Standard Company was to make the 19-inch horn, such as Exhibit 15, for \$2.00, and to divide the profit of \$1.00, each taking 50 cents. That on the 23-inch horns, such as Exhibit 14, the Standard Company were to make them for \$2.50, and they were to divide a profit of \$1.30, or 65 cents each (Record, pp. 82, 83). It is, therefore, apparent that the business which was turned over by the Searchlight Horn Company to the Standard Company under the arrangement of May 8, 1908, was its entire horn business and machinery for making the horns which it has previously made, including not only the folding horns, such as shown in Defendant's Exhibit "T," but also the other horns which the plaintiff and its predecessors had made, such as shown in Plaintiff's Exhibits 9, 11, 12 and 13, and which the plaintiff and the U. S. Horn Company had been marking with the Nielsen patent (See top p. 84).

Mr. Locke's testimony (Record, p. 83) shows that the Standard Company was (Record, pp. 77-78) was, before the said arrangement, one of the manufacturers which had previously been manufacturing the B and G horn, similar to Plaintiff's Exhibit 8, and had also previous to the arrangement made in 1908, started in to manufacture, with others, the alleged infringing horn, such as Plaintiff's Exhibit 12.

So it is clear that at the time the Searchlight Company made the arrangement with the Standard Metal Company it was then, and had been for some time before, manufacturing horns just like Plaintiff's Exhibit 12, and similar to the alleged infringing horn. After the arrangement with the plaintiff of May 8, 1908, it continued the manufacture of the said horn similar to Exhibit 12.

Mr. Locke's testimony (Record, p. 83) shows that the Standard Company was supplying the whole market. Mr. Locke is asked (Record p. 83). "The **whole matter** has been turned over to the Standard Metal Manufacturing Company under the terms which you have stated?" To this he answered, "Yes." He also states that "the Standard Metal Manufacturing Company is the largest manufacturer of talking machine horns in the country. It manufactures the bulk of the horns for the Edison Phonograph Company and the Victor Talking Machine Company."

Mr. Locke also shows (Record, p. 84) that when the U. S. Horn Company and the Searchlight Horn Company were manufacturing and selling horns they marked **every one of them with the Nielsen patent**. He also stated (Record, pp. 84-85) that the Searchlight Horn Company is having its goods marketed by the Standard Metal Manufacturing Company. Mr. Locke's previous testimony (Record, p. 79) was to the effect that the Searchlight Horn Company had sold about 35,000 horns; on page 84 of the Record he shows on cross-examination that the plaintiff Company placed on the market about 3000 or 4000 of the

horns similar to Defendant's Exhibit marked for the purpose of identification "W," subsequently marked in evidence as Defendant's Exhibit "T." So the plaintiff had before the arrangement with the Standard Metal Company marketed about 31,000 or 32,000 of the non-folding horns, according to his testimony.

The evidence then shows that the Victor Talking Machine Company, from whom the defendant, Sherman-Clay Company, bought all of its horns, had secured the said horns from the Standard Metal Manufacturing Company. Mr. Locke (Record, p. 83) had shown that the Standard Company "manufactures the bulk of the horns for the Edison Phonograph Company and the Victor Talking Machine Company." He also states (Record, p. 85) that "most of the horns (for the Victor Company) are manufactured by the Standard Metal Manufacturing Company, but the Tea Tray Company **may** make some of their horns." It will be remembered that the Victor Company sold a great many kinds of horns, and Mr. Locke does not state what construction of horn the Tea Tray Company may make for the Victor. He does not state that the Tea Tray Company did make any horns for the Victor Company, but that it "**may** make horns for the Victor Company." Mr. Locke also states (Record, p. 86) that the Standard Metal Manufacturing Company did manufacture the horns for the Victor Talking Machine Company, "and I have no doubt that they do today."

It is, therefore, apparent from plaintiff's evidence

that the Victor Talking Machine Company, by accident or otherwise, at least since May 8, 1908, was purchasing its horns from an authorized and licensed source.

### Concerning the Horns Sold by Sherman, Clay & Co.

In regard to the proof as to sales of alleged infringing horns by the defendant, Sherman, Clay & Co., let us again refer to Mr. Locke's testimony.

Mr. Locke testifies (Record, pp. 85-86) that prior to the time that the Searchlight Company ceased manufacturing, it supplied the defendant, Sherman, Clay & Co., with horns. Upon being asked who supplied the defendant company since with the alleged infringing horns (Record, p. 86) he says: "I suppose the Victor." Mr. Locke also shows (Record, p. 86) that he understands that the horns which have been placed on the market by Sherman, Clay & Co. were procured from the Victor Company with the Talking Machines. Mr. Locke also admits (Record, p. 88) that he knew before suit was brought that on all machines sold to Sherman, Clay & Co. the horns formed part of the equipment, and that they worked under the license agreement which he had explained in his direct examination.

The plaintiff's only testimony as to alleged sales of the alleged infringing horns, Plaintiff's Exhibits 14 and 15, is that of A. G. McCarthy, one of the directors of the defendant company (Record, p. 93, etc.). Mr. McCarthy is asked to look at Exhibits 14 and 15, and to state if they represent the "kind of horns that

Sherman, Clay & Co. have sold during the last six years.” He answered, “Yes, sir.” He is then asked how many of these kind of horns the defendant sold during a period of six years prior to suit brought, prior to April or May, 1911. Mr. McCarthy answered, “It amounts to approximately 7456.”

This is practically the entire testimony as to proof of alleged infringement.

There is absolutely no proof that any of these 7456 horns were sold by the defendant prior to May 8, 1908; they were purchased from the Victor Talking Machine Company, which in turn had bought its said horns from the Standard Metal Manufacturing Company, which was authorized to make the same under the arrangement with the plaintiff company.

All of these 7456 horns might have been sold by the defendant subsequent to May 8, 1908.

In view of this license arrangement proven by the plaintiff’s own witnesses, the burden was on the plaintiff to prove that the alleged infringing sales were prior to the license date. There is, therefore, no proof of any sales of an infringing horn by the defendant.

It is clear, therefore, we respectfully submit, that the Court below erred in not instructing the jury that there was no proof of infringement. (Assignment V).

Witness Locke also shows that the defendant’s alleged infringing horns were purchased from the Victor Talking Machine Company (Record, pp. 85-86). The Court also had a clear understanding that

this business was turned over to the Standard Metal Manufacturing Company by the Searchlight Company, as shown by the Court's Question (Record, p. 89) :

"The COURT.—Q. At the time of turning the business of manufacturing these horns over to the Standard Metal Company, you still retained your interest in the patent? A. Yes.

Q. The Searchlight Horn Company did?

A. Yes."

Mr. Locke's testimony shows that (page 80) "the business was running along unprofitable lines. Little manufacturers were starting up all over the country all the time and the business was unstable." He shows he tried to form a combination, and failed. He shows, that the reason he made an arrangement with the Standard Metal Company in May, 1908 (Record, p. 81) was because the Searchlight Company could not make the said horn business a success. Mr. Locke in his testimony in the equity suit against this defendant (Record, p. 48) states:

"In May, 1908, the Searchlight Horn Company was compelled to transfer its manufacturing business over to the Standard Metal Manufacturing Company of New Jersey."

It also shows that the Searchlight Horn Company, the plaintiff here, retained its interests in the patent, and relied on getting its profits from sales of the horns from the Standard Metal Manufacturing Company. It is also shown by Mr. Locke's testimony (Record, p. 88) that the Searchlight Company ceased

to manufacture these horns at the time it turned its rights over to the Standard Metal Manufacturing Company, and that the Searchlight Company has not manufactured any of these horns since, or made any effort to manufacture "other than those manufactured by the Metal Company."

It is, therefore, manifest that under the arrangement between the Searchlight Company and the Standard Metal Manufacturing Company of May, 1908, the latter company has been manufacturing and selling the alleged infringing horns under a license which provides for a share in the profits to the Searchlight Company.

#### **The Manufacturer Never Was Sued.**

It is significant that while Mr. Locke shows in his testimony, and in his affidavit in the equity proceedings, that it notified back in May and November, 1906, the various manufacturers of alleged infringing horns, it never brought suit against any of the manufacturers, and only recently brought suit against some of the dealers. (See *Hicks vs. Beardsley*, 32 Fed. Rep., 281).

It is also significant that it never brought suit against the Standard Metal Manufacturing Company. It is clear that it could plead license.

#### **THE PLAINTIFF'S LACHES AND BAD FAITH.**

The plaintiff, the Searchlight Horn Company, a corporation of the State of New York, having offices

in Brooklyn, N. Y. (Record, p. 85), is endeavoring to harass and annoy the Victor Talking Machine Company of Camden, N. J., by bringing suit at long range, crossing the continent and prosecuting suits on the Pacific Coast against one of its dealers, whereas, the issues could just as readily have been tried, with much greater convenience to both parties on the Atlantic Coast.

As substantiated by numerous decisions, suits in such cases should be primarily against the real party in interest, and not against sundry dealers in remote parts of the country. Originally, the Searchlight Company notified the Victor Company of alleged infringement of the patent in suit back in May, 1906, as shown by Mr. Locke's affidavit in the equity suit against this defendant (Appeal No. 2307, page 47), and had correspondence with the attorney of the Victor Company relative to the alleged infringement. As a matter of fact the Victor Company requested that if suit was to be brought, that it should be brought against it, to try out the issues, but the Searchlight Company replied that they had selected California as the "battle-ground." Mr. Locke shows, (Record, p. 87), on being asked why suit was brought in California, that Mr. Miller, though he had an office in New York, preferred to bring it in San Francisco.

No suit, however, was brought at all for a long time after the notice upon the Victor Company of May, 1906, and not until the present suit was brought in California in May, 1911, against Sherman, Clay & Co., one of the dealers of the Victor Talking Machine

Company. No explanation is given in this case why a suit was not brought earlier, if the plaintiff thought that it had a just claim, or why it was not brought against Standard Manufacturing Company or the Victor Company. Since the judgment in this action at law, the plaintiff has also sued this defendant, Sherman, Clay & Co., in an action in equity for alleged infringement of said Nielsen Patent, and a preliminary injunction was issued following the decision in the action at law April 28, 1913. A preliminary injunction was also subsequently entered in a suit in equity by this plaintiff against the Pacific Phonograph Company, in the same Court, for alleged infringement, based upon the judgment of the action at law in this case, in which case an appeal has also been taken, and is now before this Honorable Court. The plaintiff has now seen fit to bring suit in equity against the Victor Talking Machine Company in the U. S. District Court for the District of New Jersey, which suit was brought July 27, 1913, but no further proceedings than the filing of a Bill and Answer have been had.

Where the plaintiff means to fight a *bona fide* fight the suit should be brought against the manufacturer, or the real defendant, and not against one of its dealers, or agents; this proposition is supported by a long line of cases.

## A Grave Miscarriage of Justice May Obtain if Judgment of Lower Court Sustained.

Unless the judgment of the lower Court in this case is revised, and the defendant allowed to introduce all its evidence, and have proper instructions from the Court of which it was precluded in the trial of the case below, a very serious wrong and injustice will be done, not only the defendant, but to the Victor Talking Machine Company, and to a large number of other concerns which have manufactured or sold the said alleged infringing goods, and the plaintiff may hereafter urge if the defendant in this case be precluded from a re-trial on the ground of errors submitted, that the Victor Talking Machine Company will be precluded in other suits brought against it, as well as against its dealers, from an opportunity to present its defenses properly. It is, therefore important that this Honorable Court should give to the defendant an opportunity of having its case re-tried in view of the errors of the Court below in the former trial, as a grave injustice may be done to the defendants should this verdict, in view of the errors set forth, be allowed to stand.

### RE-DEFENDANT'S ALLEGED INFRINGEMENT.

The defendant's alleged infringing horn is illustrated in Plaintiff's Exhibits Nos. 14 and 15 (Record, pp. 46 and 83).

The evidence fails to show any infringement by the defendant. This fact we have considered in connec-

tion with the relation of the Standard Metal Manufacturing Company, but will also briefly consider it here under a separate heading.

The evidence of infringement consists in the testimony of Mr. McCarthy. He was asked by Mr. Miller: "Prior to the commencement of this suit, which was in 1911, about April or May, I think, for six years before that, can you give us some idea about the number of horns that were sold? Answer: It amounts to approximately 7456" (Record, p. 93).

It appears from the plaintiff's testimony, which is undisputed, that horns sold by the defendant and purchased from the Victor Talking Machine Company, subsequent to May 8, 1908, were made by the Standard Metal Company under an arrangement whereby the said Standard Metal Company paid a royalty to the Searchlight Company for the manufacture of said horns. Consequently the horns sold by the defendant after that date were **free from the monopoly of the patent**, and the defendant was not an infringer for selling the same. It is clear that the question covered a period of six years, and the answer did likewise, but there is no evidence tending to show whether these 7456 horns were sold by the defendant since 1908, or any before that time. There is no evidence to justify a conclusion that all of said horns were sold by the defendant prior to May 8, 1908, nor is there any presumption arising from the testimony that such horns were sold before, or after 1908, or any horn sold prior thereto. The witness might just as well have been asked how many they had sold during

the last thirty years. Therefore, we contend that there is no evidence from which the jury could find that the defendant did actually sell any of these horns prior to May 8, 1908.

Applying the rules we cannot see that there is any definite and certain evidence to justify the conclusion that any of these horns sold by the defendant were sold prior to 1908. It is a mere assumption, pure guess work. The question was asked in that form because six years is the statute of limitations, and it is in the same form that it is usually asked where the party assumes that the defendant has only been infringing for one or more years. It is a convenient form for the question. But it does not furnish any evidence that any of the horns were sold prior to May 8, 1908.

This argument on the motion for new trial evidently induced the Court to amend the judgment to One Dollar. This fact, we submit, shows evidence of doubt in the Court's mind as to the sufficiency of proof, though it did not grant a new trial.

William H. Locke Jr., President of the plaintiff company (Record, p. 85) shows that most of the horns of the Victor Company were manufactured by the Standard Metal Manufacturing Company, but the Tea Tray Co. **may** have made some horns. Mr. Locke also testifies (page 83) in reference to the 19-inch horn in evidence, such as Plaintiff's Exhibit 15, that the Standard Metal Manufacturing Company manufactured the 19-inch horn, which was a \$2.00 horn, for \$1.00, and that the Standard Company and the Searchlight Company divided the

difference, 50 cents. He also testifies (page 83) that the Standard Metal Manufacturing Company manufactured a 23-inch horn, such as is shown in Exhibit 14, for \$2.50 and charged the Searchlight Company \$1.20, and that they divided the \$1.30 so that the Searchlight Company got 65 cents. Plaintiff's Exhibits 14 and 15 represent the only alleged infringing horns in evidence. Mr. Locke also testifies (bottom page 83):

“A. Well, the Standard Metal Manufacturing Company today is the largest manufacturer of talking machine horns in the country. It manufactures the bulk of the horns for the Edison Phonograph Company and the Victor Talking Machine Company.”

It is, therefore, respectfully submitted, in view of this evidence, that there is no proof that the horns in evidence, Plaintiff's Exhibits 14 and 15, were made prior to May 8, 1908, the date of the license agreement between the Searchlight Company and the Standard Metal Manufacturing Company, and no sufficient proof of the sale of any alleged horns prior to that date. There is no proof that any of the horns containing the alleged infringement sold by the Sherman, Clay & Co. were actually sold prior to May 8, 1908, as hereinbefore pointed out (Record, p. 93, etc.). The attention of the Court is particularly called to the testimony of Mr. Locke, the President of the Searchlight Company (bottom of Record, pp. 79-80), where he testifies that before the Searchlight Horn Company ceased to manufacture, which was in May, 1908, when it turned over the business, etc., to the Stand-

ard Metal Manufacturing Company, that it had sold many of the patented horns made by it on the Pacific Coast, and that it had prior to the time that it had ceased business in May, 1908, and turned it over to the Standard Company (top of page 80), sold the said horns to Sherman, Clay & Co., the defendant in this case.

Mr. Locke also shows at top of page 84 that when the Searchlight Company was manufacturing these horns it marked them with the Nielsen Patent, so this was among the horns turned over to the Standard Manufacturing Company to be manufactured.

This we submit should be conclusive that there is no proof of infringement in this case, and that the Court erred in not so instructing the jury.

The defendant in this case does not admit the validity of the patent in suit, but as hereinbefore stated, expressly denies its validity. It, however, contends that if, as shown by plaintiff's proofs, the goods claimed to be infringements, were purchased from plaintiff's licensee, these goods are free from the monopoly of the patent, and that there can be no liability on the part of the defendant.

As hereinbefore specifically pointed out, even if the goods sold had not been licensed goods, the defendant company could not infringe claim 2, as it is specifically limited to a construction which the defendant has not used. If plaintiff's contention were true that admitting the claim is limited to specific construction, he is entitled to mechanical equivalents, the second claim then would be as broad as the third, and

there would be no reason for granting two claims on the same scope, which is contrary to Patent Office practice.

The Court below, we, therefore, respectfully submit, was manifestly in error in its instructions to the jury as to the scope of the claims of the patent in suit, as well as to the question of mechanical equivalents and infringement. The judgment of the lower Court should be reversed.

We will now consider further certain errors relative to the introduction of evidence, as well as errors in the instructions to the jury, embodied in the Assignment of Errors.

**Error of the Court in Refusing to Admit in Evidence, on Behalf of Defendant, U. S. Re-issue**

**Letters Patent No. 12,442, Granted**  
**January 30, 1906.**

This patent is a re-issue of U. S. patent No. 739,954, issued to the said Villy September 29, 1903, which original was offered in evidence and marked "Defendant's Exhibit O" (Record, 128).

This offer of the re-issued patent was objected to by plaintiff's counsel (Record, 128), which objection was sustained by the Court, an exception being noted.

It will be noted that the objection to the offer of this re-issued patent was on the ground that as it was dated January 30, 1906, it was not a prior patent, and the Court sustained the objection on this ground.

The relevancy of this Villy re-issue patent has hereinbefore been quite thoroughly considered, and it will not be necessary to reiterate its bearing here at length. Of course, the re-issued patent itself, issued January 30, 1906, was not an anticipation, as it issued after the date of Nielsen's filing on April 14, 1904, it of course dates back to the date of the original patent. This re-issued patent is, however, important, among other things, in that the plaintiff marked its flower horns, such as "Defendant's Exhibit T," with this Villy reissued patent of January 30, 1906, as also with the date of the Nielsen patent in suit, admitting thereby that this horn was constructed under the said Villy re-issued patent of January 30, 1906, as well as under the patent in suit; and it is, therefore essential to have before the Court what this Villy re-issued patent contains, and what it claims.

It will be noted that this matter comes out, and quite fully, in the cross-examination of Mr. Locke, plaintiff's President (Record, 89-90) in considering "Defendant's Exhibit T" (previously marked for identification "W"). Mr. Miller objected (Record, 90) to Mr. Acker's question relative to the original Villy patent not being marked upon the horn, but admitted that the "1906" date of this exhibit referred to the Villy patent. As the plaintiff marked its horns with this Villy re-issued patent, which, of course, goes back of the date of the filing of its original patent, it is essential to have the re-issue before the Court, which shows on its face of what patent it is a re-issue, and the date of the filing of the orig-

inal patent. It also may differ in some respects from the original patent as it is a re-issue, and this can only appear from the face of the re-issued patent, which ought to be before the Court. As the plaintiff represented to the public by marking its commercial horns with the Villy re-issued patent, that it was constructed under this Villy re-issued patent, as well as under the patent in suit, it is quite essential that the Court should have before it this Villy re-issued patent.

See Reis et al. vs. Rosenthal, 204 F. R., 282.

Holt Mfg. Co. vs. Best Mfg. Co., 172 Fed. p. 409.

The attention of this Honorable Court is also directed to a further consideration of this subject at pp.— of this Brief.

#### RE-ERROR OF THE COURT IN DENYING DEFENDANT'S MOTION,

(1) That the jury be directed to find a verdict for the defendant upon the ground that claims 2 and 3 of the patent in suit are void for want of patentable invention.

(2) That neither of said claims have been infringed by the defendant (Record, 267).

We will consider these two questions together.

It is the function of the Court to instruct the jury what the patent contains, and, as stated by the Court below in this case, to construe the patent, and

to tell the jury what it means, and it is the jury's duty to accept the construction so given. As hereinbefore pointed out, the Court clearly erred in making no differentiation in its instructions to the jury between claims 2 and 3 (claim 1 not being sued upon), and in failing to instruct the jury as to the limitations which must be observed as to claim 2, and in failing to instruct the jury as to the invalidity of claim 3. The Court erred in stating to the jury, certain essential characteristics of what invention of the Nielsen patent consisted, and in disregarding a consideration of the respective claims independently (Record, 272-273). The Court had, previously in the trial of the case, expressed its opinion to the jury as to the essence of the patent, and had stated (Record, 66):

“the essence of this patent is in the building of an instrument by strips of metal united together so as to make the whole, and that it rests in the form of the horn. The general form of the horn is constituted by strips which gives the horn this particular form and that is what they count upon.”

The Court erred in instructing the jury, in substance, that any kind of longitudinal ribs on the outer surface of the horn would be within the Nielsen invention. The Court further erred, among other things, in stating to the jury that the **strips** must curve outwardly from the inner to the outer end, and that a curve is more abrupt adjacent to the outer end. There is no such requirement in claim 2 or 3 of the patent, as previously pointed out. It is clear, therefore, that the Court misun-

derstood, and misinterpreted, claims 2 and 3, and was in error in so instructing the jury as to the essence and scope of the patent in suit. It is also manifest that the Court, by reason of this misunderstanding of the patent, and its scope, misapplied the prior art, especially relative to the Villy patent, and the other prior art hereinbefore considered, which will not be reiterated here, and should, therefore, have granted the defendant's motion to direct a verdict for the defendant on the ground that the patent was void for want of patentable invention.

The Court was also clearly in error in its instructions to the jury (Record, 271-272) relative to the patentee's right to include as an infringement horns having seams, or ribs, differently constructed from those specifically claimed and required in claim 2. Claim 2 was granted by the Patent Office because it was so narrowly limited to a specific form of rib, consisting of flanges outwardly directed butting and secured together. This was the specific construction described in Nielsen's patent, and illustrated in Figs. 3 and 4, and was made the subject-matter of the specific claims. The Patent Office, in view of these specific requirements in the claims, granted the patent. Other claims calling for ribs generally, not specifying the construction of the ribs, were rejected by the Patent Office. It was, therefore, an error for the Court, after the granting of the patent, to tell the jury that these specific claims may be infringed by horns which have other constructions of ribs. The Court erred, among other things, in stating (Record, 272):

"If the same result produced by the flanged seam shown in the patent as joining the metal strips together is obtainable by any other usual form of seam known at the time of Nielsen's invention which operates in substantially the same way to produce the same result, then the substitution of such a seam would not be a departure from the invention, but would be within its real and true scope."

Where the state of the art shows prior devices limiting the scope of the invention, the claim must be strictly construed, and confined to the exact device described, and no application of the doctrine of equivalents, either broad or narrow, can bring into such a claim the prior art. In other words, in cases of this kind the patentee is confined to his exact device or such variations therefrom as appeared to be mere evasions.

Newton vs. Furst, 119 U. S., 373.

A patentee is bound by his claims. If he acquiesces in the rejection of broad claims, and accepts claims for his specific construction, he cannot be heard to enlarge the scope of his patent by construction so as to cover devices not within its terms.

Roemer vs. Peddie, 27 Fed. 702.

Where a patentee is enabled to obtain his patent only by abandoning broader claims and inserting a precise description of his particular device, this latter device becomes essential to the claim allowed, and it does not avail him to say that he does not

wish to limit himself to any particular form of construction, or to invoke broad and liberal construction of his patent.

Norton vs. Jensen, 81 Fed. 494.

Where a patentee has pointed out in his claims the precise construction that is to be regarded as his invention by references to the drawings, his patent may properly be confined to such construction on an issue of infringement.

Schaum et al. vs. Riehl, 124 Fed. 320.

Section 4888 of the Revised Statutes requires that an applicant for a patent, "particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery."

The Courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office when the terms of the claim in a patent are clear and distinct as they always should be. A patentee in a suit brought upon the patent is bound by it. He can claim nothing beyond it.

The claim is a statutory requirement prescribed for the purpose of making the patentee define precisely what his invention is; and it is unjust to the public as well as an evasion of the law to construe it in a manner different from the plain import of its terms.

2 Rob. 488; Keystone Bridge Co. vs. Phoenix Iron Co., 95 U. S. 274; 24 L. Ed. 344, 346; White vs. Dunbar, 119 U. S. 47; 30 L. Ed. 303.

If the language of the specification and claim shows clearly that he desired to secure as a monopoly, nothing can be held an infringement which does not fall within the terms the patentee has himself chosen to express his invention.

McClain vs. Otmayer, 141 U. S. 423.

In making his claim the inventor is at liberty to choose his own form of expression, and while the Courts may construe the same in view of the specification and the state of the art, they may not add to or detract from the claim.

Cimiotti Co. vs. American Co. 198 U. S. 399; 49 L. Ed. 1100; Dey Time Register Co. vs. Syracuse Co., 161 Fed. 111; Gruth vs. International Postal Supply Co., 61 Fed. 284, 288; Schreiber et al. vs. Adams Co., 117 Fed. 830, 834; Westinghouse Co. vs. New York Co., 119 Fed. 874, 884.

The Courts should regard with jealousy and disfavor any attempts to enlarge the scope of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alterations.

Chicago et al. vs. Sayles, 97 U. S. 554.

The construction of a patent must be in conformity with the self-imposed limitations which it contained in the claims.

New Departure Bell Co. vs. Bevin et al.,  
64 Fed. 859; affirmed in 73 Fed. 469.

In conclusion upon this branch of the subject we urge that, viz: If the old lock or lap seam used in the prior phonographic horns and the outwardly directed flanges which form the body of the patented horn are the mechanical equivalents of each other, then what did Nielsen invent? Phonographic horns were old, phonographic horns made with a plurality of tapering strips and having the tapering strips fastened together with a lap seam, to form the body of the horn, were old. Along the line of union of the strips was also a protrusion of metal. Now what is left? In our opinion, if this patent can be sustained at all, it must be for simply an improvement of the old lap or lock seam consisting of the new idea of substituting for these old seams the outwardly directed flanges which by their method of union formed the rib of the patent, and the patentee must be confined to this specific device and none other. He can not be permitted to say that these old seams are the equivalents of his flanged rib made in forming the body of the horn in order to make out infringement.

The substitution of an equivalent is not invention.

Smith vs. Nichols, 21 Wall. 112; Atlantic Works vs. Brady, 107 U. S. 192; Hollister vs. Mfg. Co., 113 U. S. 59; Aron vs. Railway Co., 132 U. S. 85; Trimmer Co. vs. Slivers, 137 U. S. 425; Mfg. Co. vs. Cary, 147 U. S. 623.

Attention is also called to the clear error of the Court (Record, 276), wherein it states: "The metal strips constituting the **defendant's** horn are secured together by a seam or joint known as a flange or **butt** seam." The metal strips of defendant's horn are not secured together by a "butt seam," as stated by the Court, which is the specific seam of claim 2 of the patent and as illustrated in the drawings, but are secured together by a **lock** seam, as clearly shown by the evidence. This misstatement may very readily have misled the jury.

The Court also erred in not instructing the jury that all Nielsen did, if anything, was the exercising of mechanical skill rather than ingenuity. The question of the prior art has been so fully considered as to the question of invalidity of the claims, that it will not further be reviewed here. The Court, we respectfully submit, in view of the facts hereinbefore shown, which will not here be repeated, and in view of this showing, should have instructed the jury that the claims ruled upon were both void for want of patentable invention, for the Court should have instructed the jury that claim involved a narrow specific construction, which the defendant did not infringe.

The Court erred in not instructing the jury that the claims were not infringed by the defendant.

The rule established by the Supreme Court of the United States in the case of Singer Co. vs. Cramer, 192 U. S. 265, is that "where the question of infringement depends entirely upon the construction of the patent, either upon its face or in connection with facts, of such a nature and effect, as not to be reasonably disputed, the question is one of law for the Court."

See also Western Electric Co. vs. Robertson, 142 Fed. 471, 478; De Loriea vs. Whitney, 63 Fed. 611; Black Diamond Co. vs. Excelsior, 156 U. S. 611.

In the Robertson case above cited, in speaking of a similar question at the conclusion of the opinion which was given by the Circuit Court of Appeals of the Second Circuit in 1909, the Court said: "In interpreting the Robertson patent we must read into it the limitations imposed by the disclosure of Eaton. A comparison of defendant's structure with that of Eaton shows that the defendant had simply taken the Eaton structure with the wing or portion of a wheel above the core-tube and improved upon it. We are of the opinion, therefore, that the construction of the patent in suit is to be determined as a matter of law by the limitations of the prior art, and when thus interpreted, its scope cannot be extended to embrace the defendant's structure." This is particularly applicable to the case at bar, because in interpreting

the plaintiff's patent we must read into it the limitations imposed by the disclosures made, not only by the file wrapper, but particularly the exhibits of the defendant which showed phonographic horns made of a plurality of tapering strips larger at one end than the other and the edges of the strips fastened together by the old style lap or lock seams. It is evident that Nielsen took this old structure and improved upon it, if he did anything, by devising and patenting his new idea of outwardly directed flanges by which the strengthening ribs were formed. It is likewise equally clear from the evidence that defendant used that specific device of the old art. Consequently, we say that the Court should have held as a matter of law that the defendant did not infringe.

In Cummings vs. Baker & Hamilton, 144 Fed. 395, it appears that at the trial in the Court below and at the close of all the evidence, the counsel for the defendant requested the Court to direct the verdict for the defendant on the ground of non-infringement. The motion was granted and the jury was so instructed. Judgment for the defendant followed, and the judgment was affirmed by the Court of Appeals, Judge Ross rendering its opinion.

It will also be noted that the Court erred (Record 276) in instructing the jury that it should find that there was no anticipation of the Nielsen patent "unless you find in **ONE** of these prior devices or patents a disclosure and description of the Nielsen invention as heretofore construed by me." It is respectfully submitted that this was misleading to the jury, as the impression to the non-technical

mind, by reason of this statement, would be an erroneous one, that the patent could not be invalidated unless exactly the same thing as claimed was shown in **one** separate and independent prior device or patent.

The court also manifestly erred, in view of the evidence, in not instructing the jury regarding the license of the plaintiff to the Standard Metal Mfg. Co., to manufacture the patented horns, and in not instructing the jury to the effect that if it found that the infringing horns were purchased by the defendant, directly or indirectly, from the said licensee, there was no evidence of purchase prior to the date of the license, of May 8, 1908, that there could be no infringement, and that the verdict should be for the defendant.

The Court also erred in refusing to instruct the jury, as requested by defendant, as specified in the Assignment of Errors on the grounds heretofore urged.

#### CONCLUSION.

It is respectfully submitted that, in view of the foregoing, the judgment of the court below should be reversed, and a new trial awarded, with costs to the defendant. The issues involved in this case are very important, and far reaching, and may also affect others than the defendant in a manner which may work grave injustice, should there be no opportunity given by a reversal to re-try the issues of this case in a case where the jury may

have the benefit of proper instructions from the Court, with the elimination of errors which tended to lead the jury to an erroneous conclusion in the finding of facts.

All of which is respectfully submitted:—

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November 8, 1913.